

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Applicant: Stephen J. Brown

Application No.: 09/665,442 Examiner: Koppikar, V.

Filed: September 19, 2000 Art Group: 3686

For: MULTI-USER REMOTE HEALTH MONITORING SYSTEM WITH
BIOMETRICS SUPPORT

APPEAL BRIEF

Mail Stop - Appeal Brief Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Appellant submits the following Appeal Brief pursuant to 37 C.F.R. §41.37 for consideration by the Board of Patent Appeals and Interferences. Enclosed herewith is the charge \$1180 to cover the cost of (i) filing the opening brief, as required by 37 C.F.R. §41.20(b)(2), and (ii) a two month extension of time, as required by 37 C.F.R. §1.17(a)(1). Please charge any additional fees or credit any overpayment to Deposit Account Number 50-0541.

TABLE OF CONTENTS

- I. REAL PARTY IN INTEREST
- II. RELATED APPEALS AND INTERFERENCES
- III. STATUS OF CLAIMS
- IV. STATUS OF AMENDMENTS
- V. SUMMARY OF CLAIMED SUBJECT MATTER
- VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL
- VII. ARGUMENTS
 - A. Rejections under 35 U.S.C. §102
 - B. Rejections under 35 U.S.C. §103
 - C. Conclusion
- VIII. CLAIM APPENDIX
- IX. EVIDENCE APPENDIX
- X. RELATED PROCEEDINGS APPENDIX

I. REAL PARTY IN INTEREST

The real parties in interest are Health Hero Network, Inc., the assignee of record and a subsidiary of the Robert Bosch North America, and Abbott Diabetes Care, a subsidiary of Abbott Laboratories, Inc., a licensee of the application.

II. RELATED APPEALS AND INTERFERENCES

The following appeals, which may have a bearing on the Board's decision in the pending appeal, are known to the Appellant, Appellant's legal representative, or Assignee, (i) a prior appeal in the present application, decided May 25, 2011, which involved rejections under Fujimoto¹ for claims that have since been amended (see discussions in Section VII Arguments) and (ii) Application 09/237,194, decided April 20, 2010, which included a rejection involving Fujimoto but only considered if Appellant's Declaration under 37 C.F.R. §1.131 overcame Kirk et al.²

Other appeals known to Appellant's legal representative and owned by the Assignee are provided as follows for completeness. These appeals do not involve any references in common with the pending appeal and therefore are not believed to directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal, (i) Application 11/451,546 decided March 10, 2011, (ii) Application 11/473,960 pending, (iii) Application 11/511,793 pending, (iv) Application 11/509,337 pending, (v) Application 09/810,334 decided February 8, 2011, (vi) Application 10/741,168 decided October 29, 2008 and October 18, 2010, (vii) Application 11/528,737 pending, (viii) Application 11/509,425 pending, (ix) Application 11/524,117 pending, (x) Application 11/610,156 pending, (xi) Application 11/614,302 pending, (xii) Application 11/748,148 pending, (xiii) Application 10/279,749 pending and (xiv) Application 11/226,404 pending.

There are no related interferences known to the Appellant, Appellant's legal representative, or Assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

¹ U.S. Patent No. 5,339,821.

² U.S. Patent No. 5,390,238.

III. STATUS OF CLAIMS

Claims 1-46, 50 and 63-76 have been cancelled. Claims 47-49, 51-62 and 77-110 are pending and remain rejected. The Appellant hereby appeals the rejection of claims 47-49, 51-62 and 77-110.

IV. STATUS OF AMENDMENTS

Appellant is appealing an Office Action issued by the Examiner on August 19, 2011.

On November 17, 2011, Appellant filed a Notice of Appeal.

V. SUMMARY OF CLAIMED SUBJECT MATTER

In a first embodiment, represented by independent claim 47, the presently claimed invention provides a system for monitoring a physiological condition of an individual using a communication network (e.g., see element 24, FIG. 1), comprising: a central processing unit (e.g., see element 18, FIG. 1) (A) having access to one or more databases (e.g., see element 38, FIG. 2) and (B) configured to (i) read a template program (e.g., see page 41, line 20 of the specification) from the database (38), (ii) generate a first program (e.g., see element 40, FIG. 2) by modifying the template program in response to input data received via the communication network (24), wherein the first program (40) collects measurement data (e.g., see element 44, FIG. 2) relating to the physiological condition of the individual, (iii) assign the first program (40) to the individual in response to input information received from the communication network (24) and (iv) transmit the first program (40) via the communication network (24); a remote processing apparatus (e.g., see element 26, FIG. 1) remotely located from and in signal communication with the central processing unit (18) via the communication network (24), wherein the remote processing apparatus (26) is configured to (i) receive the first program (40) from the communication network (24), (ii) connect to a measuring device (e.g., see element 28, FIG. 1), (iii) execute the first program (40) to collect the measurement data (44) according to a collect command (e.g., see page 24, line 4 of the specification) contained in the first program (40) and (iv) transmit the measurement data (44) to the central processing unit (18) via the communication network (24) according to a transmit command contained in the first program (40); and a computer (e.g., see element 20, FIG. 1) remotely located from and in signal communication with the central processing (18) unit via the communication

network (24), wherein the computer (20) is configured to (i) transmit the input data to the central processing unit (18) via the communication network (24), (ii) transmit the input information to the central processing unit (18) via the communication network (24), (iii) receive the measurement data (44) from the central processing unit (18) via the communication network (24) and (iv) present a report generated (e.g., see element 54, FIG. 1) based on the measurement data (44) to a health care provider.

In a second embodiment, represented by independent claim 59, the presently claimed invention provides a system for monitoring a physiological condition of an individual using a communication network (24), comprising: a central processing unit (18) (A) having access to one or more databases (38) and (B) configured to (i) generate a first program (40) that collects blood glucose data relating to the physiological condition of the individual, (ii) add input data received from the communication network (24) to the first program (40) to adapt the first program (40) to the individual, (iii) assign the first program (40) to the individual in response to input information received (e.g., see page 28, lines 1-4 of the specification) from the communication network (24) and (iv) transmit the first program (40) via the communication network; a remote processing apparatus (26) remotely located from and in signal communication with the central processing unit (18) via the communication network (24), wherein the remote processing apparatus (26) is configured to (i) receive the first program (40) from the communication network (24), (ii) connect to a measuring device (28), (iii) execute the first program (40) to collect the blood glucose data according to a collect command in the first program (40) and (iv) transmit the blood glucose data to the central processing unit (18) via the communication network (24); and a computer (20) remotely located from

and in signal communication with the central processing unit (18) via the communication network (24), wherein the computer (20) is configured to (i) transmit the input data to the central processing unit (18) via the communication network (24), (ii) transmit the input information to the central processing unit (18) via the communication network (24), (iii) receive the blood glucose data from the central processing unit (18) via the communication network (24) and (iv) present a report generated (54) based on the blood glucose data to a health care provider.

In a third embodiment, represented by independent claim 77, the presently claimed invention provides a method of monitoring a physiological condition of an individual using a communication network (24), the method comprising the steps of: (A) transmitting input data from a computer (20) to a central processing unit (18) via the communication network (24), wherein the computer (20) is remotely located from and in signal communication with the central processing unit (18) via the communication network (24); (B) transmitting input information from the computer (20) to the central processing unit (18) via the communication network (24); (C) reading a template program from a database (38) into the central processing unit (18); (D) generating a first program (40) in the central processing unit (18) by modifying the template program in response to the input data; (E) assigning the first program (40) to the individual in response to the input information; (F) transferring the first program (40) from the central processing unit (18) to a remote processing apparatus (26) via the communication network (24), wherein the remote processing apparatus (26) is remotely located from and in signal communication with the central processing unit (18) via the communication network (24); (G) connecting the remote processing apparatus (26) to a measuring device (28); (H) executing the first program (40) in the remote processing apparatus (26) to collect

measurement data (44) from the measuring device (28); (I) transmitting the measurement data (44) from the remote processing apparatus (26) to the central processing unit (18) via the communication network (24); (J) transmitting the measurement data (44) from the central processing unit (18) to the computer (20) via the communication network (24); and (K) presenting a report generated (54) based on the measurement data (44) from the computer (20) to a health care provider (e.g., see page 25, lines 4-6 of the specification).

In a fourth embodiment, represented by independent claim 84, the presently claimed invention provides a method of monitoring a physiological condition of an individual using a communication network (24), the method comprising the steps of: (A) transmitting input data from a computer (20) to a central processing unit (18) via the communication network (24), wherein the computer (20) is remotely located from and in signal communication with the central processing unit (18) via the communication network (24); (B) transmitting input information from the computer (20) to the central processing unit (18) via the communication network (24); (C) adding the input data received from the computer (20) to a first program (40) in the central processing (18) to adapt the first program (40) to the individual, wherein the first program (40) collects blood glucose data relating to the physiological condition of the individual; (D) assigning the first program (40) to the individual in response to the input information; (E) transmitting the first program (40) from the central processing unit (18) to the a remote processing apparatus (26) via the communication network (24), wherein the remote processing apparatus (26) is remotely located from and in signal communication with the central processing unit (18) via the communication network (24); (F) connecting the remote processing apparatus (26) to a measuring device (28); (G) executing the first

program (40) in the remote processing apparatus (26) to collect the blood glucose data from the measuring device (28) according to a collect command (e.g., see page 22, line 6 of the specification) of the first program (40); (H) transmitting the blood glucose data from the remote processing apparatus (26) to the central processing unit (18) through the communication network (24); (I) transmitting the blood glucose data from (e.g., see page 23, line 2 of the specification) the central processing unit (18) to the computer (20) via the communication network (24); and (J) presenting a report generated (54) based on the blood glucose data from the computer (20) to a health care provider.

In a fifth embodiment, represented by independent claim 91, the presently claimed invention provides one or more processor readable non-transitory storage devices having processor readable code embodied thereon, the processor readable code being configured to program one or more processors to perform a method of monitoring a physiological condition of an individual using a communication network (24), the method comprising the steps of: (A) transmitting input data from a computer (20) to a central processing unit (18) via the communication network (24), wherein the computer (20) is remotely located from and in signal communication with the central processing unit (18) via the communication network (24); (B) transmitting input information from the computer (20) to the central processing unit (18) via the communication network (24); (C) reading a template program from a database (38) into the central processing unit (18); (D) generating a first program (40) in the central processing unit (18) by modifying the template program in response to the input data; (E) assigning the first program (40) to the individual in response to the input information; (F) transmitting the first program (40) from the central processing unit (18) to a remote processing

apparatus (26) via the communication network (24), wherein the remote processing apparatus (26) is remotely located from and in signal communication with the central processing unit (18) via the communication network (24); (G) connecting the remote processing apparatus (26) to measuring device (28); (H) executing the first program (40) in the remote processing apparatus (26) to collect measurement data (44) from the measuring device (28); (I) transmitting the measurement data (44) from the remote processing apparatus (26) to the central processing unit (18) via the communication network (24); (J) transmitting the measurement data (44) from the central processing unit (18) to the computer (20) via the communication network (24); and (K) presenting a report generated (54) based on the measurement data (44) from the computer (20) to a health care provider.

In a sixth embodiment, represented by independent claim 98, the presently claimed invention provides one or more processor readable non-transitory storage devices having processor readable code embodied thereon, the processor readable code configured to program one or more processors to perform a method of monitoring a physiological condition of an individual using a communication network (24), the method comprising the steps of: (A) transmitting input data from a computer (20) to a central processing unit (18) via the communication network (24), wherein the computer (20) is remotely located from and in signal communication with the central processing unit (18) via the communication network (24); (B) transmitting input information from the computer (20) to the central processing unit (18) via the communication network (24); (C) adding the input data received from the computer (20) to a first program (40) in the central processing (18) to adapt the first program (40) to the individual, wherein the first program collects blood glucose data relating to the physiological condition of the individual; (D) assigning the first program (40) to the individual in

response to the input information; (E) transmitting the first program (40) from the central processing unit (18) to the a remote processing apparatus (26) via the communication network (24), wherein the remote processing apparatus (26) is remotely located from and in signal communication with the central processing unit (18) via the communication network (24); (F) connecting the remote processing apparatus (26) to a measuring device (28); (G) executing the first program (40) in the remote processing apparatus (26) to collect from the measuring device (28) according to a collect command of the first program (40); (H) transmitting the blood glucose data from the remote processing apparatus (26) to the central processing unit (18) through the communication network (24); (I) transmitting the blood glucose data from the central processing unit (18) to the computer (20) via the communication network (24); and (J) presenting a report generated (54) based on the blood glucose data from the computer (20) to a health care provider.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The first ground of rejection is whether claims 47, 55-57, 77, 84, 91, 98, 105 and 107-110 are patentable under 35 U.S.C. §102(b) over Fujimoto, US Patent Number 5,339,821.

The second ground of rejection is whether claims 48, 49, 51-54, 58-62, 78-83, 85-90, 92-97, 99-104 and 106 are patentable under 35 U.S.C. §103(a) over Fujimoto.

VII. ARGUMENTS

A. 35 U.S.C. §102

As set forth on page 2 of the Office Action,³ claims 47, 55-57, 77, 84, 91, 98, 105 and 107-110 are rejected under 35 U.S.C. § 102(b) as being anticipated by Fujimoto.

The Federal Circuit has stated: “A claim is anticipated only if *each and every element* as set forth in the claim is found, either *expressly or inherently* described, in a single prior art reference.”⁴ “The elements must be *arranged as required by the claim*.”⁵ The Federal circuit has added that the anticipation determination is viewed from one of ordinary skill in the art: “There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention.”⁶ As explained herein below, because Fujimoto does not disclose each and every element of the claims, arranged as in the claims, Fujimoto does not anticipate the claimed invention.

³ Mailed August 19, 2011.

⁴ Manual of Patent Examining Procedure (M.P.E.P.), Eighth Edition, Rev. 8, July 2010, §2131 citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, USPQ2d 1051, 1053 (Fed. Cir. 1987) (emphasis added).

⁵ M.P.E.P. §2131 citing *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990) (emphasis added).

⁶ *Scripps Clinic & Research Found. v. Genentech Inc.*, 927 F.2d 1565, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991).

1. Claims 47, 55-57, 77, 84, 91, 98, 105 and 107-110 are patentable over Fujimoto.

As set forth on page 2 of the final Office Action,⁷ claims 47, 55-57, 77, 84, 91, 98, 105 and 107-110 are rejected under 35 U.S.C. § 102(b) as being unpatentable over Fujimoto.

Claims 47, 55-57, 77, 84, 91, 98, 105 and 107-110 do not stand or fall together. Rather, claims 47 and 55-57 (Group I), claims 77 and 91 (Group II), claims 84 and 98 (Group III) and claims 105 and 107-110 (Group IV) are argued separately.

a. The rejection of claims 47-55-57 over Fujimoto is not sustainable and should be reversed.

Claim 47 of the present invention provides a system for monitoring a physiological condition of an individual using a communication network, comprising:

a central processing unit (A) having access to one or more databases and (B) configured to (i) read a template program from the database, (ii) generate a first program by modifying the template program in response to input data received via the communication network, wherein the first program collects measurement data relating to the physiological condition of the individual, (iii) assign the first program to the individual in response to input information received from the communication network and (iv) transmit the first program via the communication network;

a remote processing apparatus remotely located from and in signal communication with the central processing unit via the communication network, wherein the remote processing

⁷ Mailed August 19, 2011.

apparatus is configured to (i) receive the first program from the communication network, (ii) connect to a measuring device, (iii) execute the first program to collect the measurement data according to a collect command contained in the first program and (iv) transmit the measurement data to the central processing unit via the communication network according to a transmit command contained in the first program; and

a computer remotely located from and in signal communication with the central processing unit via the communication network, wherein the computer is configured to (i) transmit the input data to the central processing unit via the communication network, (ii) transmit the input information to the central processing unit via the communication network, (iii) receive the measurement data from the central processing unit via the communication network and (iv) present a report generated based on the measurement data to a health care provider.

In contrast, the cited reference does not disclose or suggest all of the claimed limitations as arranged in the claims for the following reasons.

Claim 47 provides (i) a central processing unit, (ii) a remote processing apparatus remotely located from and in signal communication with the central processing unit via the communication network and (iii) a computer remotely located from and in signal communication with the central processing unit via the communication network. In contrast, Fujimoto is silent regarding all three types of machines on a communication network as provided in the claims. Therefore, the claims include limitations not disclosed or suggested by the cited reference.

In particular, FIG. 1 of Fujimoto illustrates a medical apparatus 8 connected to a host computer 5 via a telecommunication line 4. The Examiner asserts that the medical apparatus 8 of

Fujimoto is similar to the claimed remote processing apparatus and the host computer 5 is similar to the claimed central processing unit. However, the Examiner does not identify any element of Fujimoto that is allegedly similar to the claimed computer. All that the Examiner cites in FIG. 1 is the entire FIG. 1 (see page 3 of the Office Action). However, FIG. 1 and the rest of Fujimoto are silent regarding another type of computer connected to the host computer 5 by way of the telecommunication line 4.

The May 25, 2011 Decision on Appeal asserted that a display unit sitting on top of the computer 5 is similar to the formerly claimed workstation, see finding of fact 10. The May 25, 2011 Decision on Appeal broadly interpreted the former claim term “workstation” to include the display unit of Fujimoto. Appellant did not agree with the broad interpretation, but in order to advance the prosecution, clarified that the claim provided a computer remotely located from and in signal communication with the central processing unit via the communication network. The display unit of Fujimoto itself is not a computer, it is not remotely located from the host computer 5 and it is not in signal communication with the host computer 5 via the telecommunication line 4. Due to the amendment to the claim language, the display unit of Fujimoto does not disclose or suggested the claimed computer. As such, the May 25, 2011 Decision on Appeal finding of fact 10 is no longer applicable. The Examiner does not identify any element of Fujimoto allegedly similar to the claimed computer. Fujimoto itself is silent regarding a third element on the telecommunication line 4 and remotely located from the host computer 5 that could potentially be similar to the claimed computer. Therefore, the cited reference does not disclose or suggest (i) a central processing unit, (ii) a remote processing apparatus remotely located from and in signal communication with the central processing

unit via the communication network and (iii) a computer remotely located from and in signal communication with the central processing unit via the communication network, as presently claimed.

Claim 47 further provides that the computer is configured to (i) transmit the input data to the central processing unit via the communication network and the central processing unit is configured to (i) read a template program from a database and (ii) generate a first program by modifying the template program in response to input data received via the communication network. In contrast, the host computer 5 of Fujimoto does not generate a user-specific first program by modifying a template program based on input data received via telecommunication line 4. Therefore, the claims include limitations not disclosed or suggested by the cited reference.

The Examiner asserts that Fujimoto explicitly discloses the above claimed limitations in column 2 lines 32-55, column 4 lines 12-68, column 8 lines 8-39, column 9 line 10-column 10 line 10 (see Office Action⁸ page 3) and column 2 line 65-column 3 line 30 (see Office Action⁹ page 5). In contrast, none of the cites in Fujimoto provided by the Examiner mention a computer (other than the medical apparatus 8) sending the host computer 5 input data via the telecommunication line 4. None of the cites in Fujimoto provided by the Examiner mention the host computer 5 reading a template program from a database. None of the cites in Fujimoto provided by the Examiner mention the host computer 5 generating a first program by modifying the template program in response to the input data allegedly received via the telecommunication line 4. The Examiner has done no more than

⁸ Mailed August 19, 2011.

⁹ Mailed August 19, 2011.

provide multiple cites to several columns of text with no explanation of how Fujimoto allegedly discloses the claimed limitations. Fujimoto itself is silent regarding any element similar to at least the claimed computer and the claimed template program. Therefore, the claims include limitations not disclosed or suggested by the cited reference.

Furthermore, the May 25, 2011 Decision on Appeal concluded that a list of numbers, for questions already stored in the medical apparatus 8 of Fujimoto is similar to the claimed program, see findings of fact 5 in the May 25, 2011 Decision on Appeal. Assuming, *arguendo*, that the finding of fact 5 is correct (for which the Appellant's representative does not necessarily agree), Fujimoto is silent that the doctor enters the input data through a computer remotely located from the host computer 5. Fujimoto is silent that the list of numbers for the questions is generated by the host computer 5 in response to the input data received over telecommunication line 4. Fujimoto is also silent that the list of numbers for the questions is a modified version of a template program read from a database. The "medical side" mentioned in column 5 line 68-column 6 line 9 by the finding of fact 5 refers to the host computer 5 side of the telecommunication line 4 per column 2 lines 50-55 of Fujimoto. However, FIG. 1 of Fujimoto does not show another computer located on the host computer 5 side of the telecommunication line 4 that is in signal communication with the host computer 5 via the telecommunication line 4. Hence, the finding of fact 5 from the May 25, 2011 Decision on Appeal is no longer applicable to the presently pending claims. Therefore, the cited reference does not disclose or suggest that the computer is configured to (i) transmit the input data to the central processing unit via the communication network and the central processing unit is configured to (i) read a template program from a database and (ii) generate a first program by

modifying the template program in response to input data received via the communication network, as presently claimed.

Claim 47 further provides that the central processing unit is configured to (iv) transmit the first program via the communication network and the remote processing apparatus configured to execute the first program to collect measurement data according to a collect command contained in the first program. In contrast, the list of numbers in Fujimoto does not contain information necessary for the medical apparatus 8 to collect information from a measuring device, such as the medical terminal equipment 1 of Fujimoto. Instead, the program of Fujimoto appears to be nothing more than a list of numbers. One of ordinary skill in art would not understand a number to be an executable command. One of ordinary skill in the art would not appear to understand that a number can cause the medical apparatus 8 to collect data from the medical terminal equipment 1. Therefore, the claims include limitations not disclosed or suggested by the cited reference.

In particular, Fujimoto states that the questions for diagnosis inquiry are stored in advance in the medical terminal equipment 1 (see column 5 lines 64-66). It is these pre-loaded programs containing the questions that appear to be executed by the medical apparatus 8 of Fujimoto to present the questions to the patient. The list of numbers merely identifies which parts of the program are used. Therefore, Fujimoto teaches that the program executed by the medical apparatus 8 is "loaded in advance" instead of being downloaded from the host computer 5 via the telecommunication line 4.

Furthermore, the findings of fact 7 from the May 25, 2011 Decision on Appeal indicates that Fujimoto discloses a script program executing in the medical apparatus 8 to initiate collection of data from the attached medical terminal equipment 1. However, the finding of fact 7 is silent regarding the program in question being generated in the host apparatus 5 and then transfer to the medical apparatus 8 over the telecommunication line 4. The finding of fact 7 and the finding of fact 5 appear to mention two different “programs”, one that initiates collection of data and the other which contains a list of numbers. The program from the finding of fact 5 does not contain not commands to initiate collection of data. On the other hand, the program from the finding of fact 7 appears to be a built-in capability of the medical apparatus 8. There is no reason why the medical terminal equipment 1 of Fujimoto would be built to measure blood pressure and pulse (see column 2 lines 36-38) and yet not have the necessary software to measure the blood pressure and pulse as part of the equipment. Therefore, the May 25, 2011 Decision on Appeal finding of fact 7 is not applicable to the presently pending claims. Fujimoto discloses a different configuration than as presently claimed.

Regarding the claimed collect command in the first program, page 8 of the May 25, 2011 Decision on Appeal asserts that “by virtue of the inherent command characteristics of software, executing a command [is] part of the programming that causes the remote processing apparatus to transmit measurement data to the central processing unit.” Inherency requires certainty of results, not mere possibility.¹⁰ M.P.E.P. §2112 also requires the Office to provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic

¹⁰ See, e.g., *Ethyl Molded Products Co. v. Betts Package, Inc.*, 9 U.S.P.Q. 2d 1001 (E.D.Ky 1988). See also, *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (C.C.P.A. 1981).

necessarily flows from the teachings of the applied prior art. However, no basis in fact or technical reasoning have been provided by the Office. The Examiner also does not support the inherency argument. Therefore, the inherency argument is merely conclusory statement no longer support by the Office and it should be withdrawn.

In particular, there is no certainty that list of numbers transferred from the host computer 5 to the medical apparatus 8 of Fujimoto includes a transmit command that necessarily causes measurement data to be transmitted back to the host computer 5. Other software, firmware and/or hardware built into the medical apparatus 8 could also cause the transmission. Therefore, the inherency argument on page 8 of the May 25, 2011 Decision on Appeal is in error and should be withdrawn. The Examiner does not support the inherency argument on page 8 of the May 25, 2011 Decision on Appeal. On page 5 of the Office Action,¹¹ the Examiner asserts that the “Office has carefully reviewed the decision mailed by the Board on May 25, 2011 and it has not found that the Board made any inherency arguments in their decision.” Consequently, the Examiner did not provide the basis in fact and/or technical reasoning to reasonably support the determination that the alleged inherent characteristic necessarily flows from the teaching of the applied prior art as required. The inherency argument appears to be withdrawn by the Examiner. Therefore, the cited reference does not disclose or suggest that the central processing unit is configured to (iv) transmit the first program via the communication network and the remote processing apparatus configured to execute the first program to collect measurement data according to a collect command contained in the first program, as presently claimed.

¹¹ Mailed August 19, 2011.

In summary, Fujimoto does not explicitly or inherently disclose or suggest all three of the claimed (i) central processing unit, (ii) remote processing apparatus remotely located from and in signal communication with the central processing unit via the communication network and (iii) computer remotely located from and in signal communication with the central processing unit via the communication network. Fujimoto does not disclose or suggest that the missing computer is configured to (i) transmit input data to the central processing unit via the communication network and the central processing unit is configured to (i) read a template program from a database and (ii) generate a first program by modifying the template program in response to input data received via the communication network. Fujimoto also fails to disclose or suggest that the central processing unit is configured to (iv) transmit the first program via the communication network and the remote processing apparatus configured to execute the first program to collect measurement data according to a collect command contained in the first program. No attempt is made by the Examiner to show that the missing elements are inherent to Fujimoto.

For the reasons presented above, claims 47 and 55-57 are independently patentable over the cited reference and the rejection should be reversed.

Claims 47 and 55-57 have been grouped and argued separately by Appellant as identified by the separate subheading under which the above arguments appear. Appellant respectfully requests that the Board provide explicit analysis and reasoning concerning the patentability of claim and the reasons why the rejection is (or is not) reversed.¹²

¹² MPEP §1205 and §1205.02.

- b. The rejection of claims 77 and 91 over Fujimoto is not sustainable and should be reversed.**

Claim 77 of the present invention provides a method of monitoring a physiological condition of an individual using a communication network, the method comprising the steps of:

(A) transmitting input data from a computer to a central processing unit via the communication network, wherein the computer is remotely located from and in signal communication with the central processing unit via the communication network;

(B) transmitting input information from the computer to the central processing unit via the communication network;

(C) reading a template program from a database into the central processing unit;

(D) generating a first program in the central processing unit by modifying the template program in response to the input data;

(E) assigning the first program to the individual in response to the input information;

(F) transferring the first program from the central processing unit to a remote processing apparatus via the communication network, wherein the remote processing apparatus is remotely located from and in signal communication with the central processing unit via the communication network;

(G) connecting the remote processing apparatus to a measuring device;

(H) executing the first program in the remote processing apparatus to collect measurement data from the measuring device;

(I) transmitting the measurement data from the remote processing apparatus to the central processing unit via the communication network;

(J) transmitting the measurement data from the central processing unit to the computer via the communication network; and

(K) presenting a report generated based on the measurement data from the computer to a health care provider.

In contrast, the cited reference does not disclose or suggest all of the claimed limitations as arranged in the claims for the following reasons.

Claim 77 provides (i) a central processing unit, (ii) a remote processing apparatus remotely located from and in signal communication with the central processing unit via the communication network and (iii) a computer remotely located from and in signal communication with the central processing unit via the communication network. In contrast, Fujimoto is silent regarding all three types of machines on a communication network as provided in the claims. Therefore, the claims include limitations not disclosed or suggested by the cited reference.

In particular, FIG. 1 of Fujimoto illustrates a medical apparatus 8 connected to a host computer 5 via a telecommunication line 4. The Examiner asserts that the medical apparatus 8 of Fujimoto is similar to the claimed remote processing apparatus and the host computer 5 is similar to the claimed central processing unit. However, the Examiner does not identify any element of Fujimoto that is allegedly similar to the claimed computer. All that the Examiner cites in FIG. 1 is the entire FIG. 1 (see page 3 of the Office Action). However, FIG. 1 and the rest of Fujimoto are

silent regarding another type of computer connected to the host computer 5 by way of the telecommunication line 4.

The May 25, 2011 Decision on Appeal asserted that a display unit sitting on top of the computer 5 is similar to the formerly claimed workstation, see finding of fact 10. The May 25, 2011 Decision on Appeal broadly interpreted the former claim term “workstation” to include the display unit of Fujimoto. Appellant did not agree with the broad interpretation, but in order to advance the prosecution, clarified that the claim provided a computer remotely located from and in signal communication with the central processing unit via the communication network. The display unit of Fujimoto itself is not a computer, it is not remotely located from the host computer 5 and it is not in signal communication with the host computer 5 via the telecommunication line 4. Due to the amendment to the claim language, the display unit of Fujimoto does not disclose or suggested the claimed computer. As such, the May 25, 2011 Decision on Appeal finding of fact 10 is no longer applicable. The Examiner does not identify any element of Fujimoto allegedly similar to the claimed computer. Fujimoto itself is silent regarding a third element on the telecommunication line 4 and remotely located from the host computer 5 that could potentially be similar to the claimed computer. Therefore, the cited reference does not disclose or suggest (i) a central processing unit, (ii) a remote processing apparatus remotely located from and in signal communication with the central processing unit via the communication network and (iii) a computer remotely located from and in signal communication with the central processing unit via the communication network, as presently claimed.

Claim 77 further provides (A) transmitting input data from the computer to the central processing unit via the communication network, (C) reading a template program from a database into the central processing unit and (D) generating a first program in the central processing unit by modifying the template program in response to the input data. In contrast, the host computer 5 of Fujimoto does not generate a user-specific first program by modifying a template program based on input data received via telecommunication line 4. Therefore, the claims include limitations not disclosed or suggested by the cited reference.

The Examiner asserts that Fujimoto explicitly discloses the above claimed limitations in column 2 lines 32-55, column 4 lines 12-68, column 8 lines 8-39, column 9 line 10-column 10 line 10 (see Office Action¹³ page 3) and column 2 line 65-column 3 line 30 (see Office Action¹⁴ page 5). In contrast, none of the cites in Fujimoto provided by the Examiner mention a computer (other than the medical apparatus 8) sending the host computer 5 input data via the telecommunication line 4. None of the cites in Fujimoto provided by the Examiner mention the host computer 5 reading a template program from a database. None of the cites in Fujimoto provided by the Examiner mention the host computer 5 generating a first program by modifying the template program in response to the input data allegedly received via the telecommunication line 4. The Examiner has done no more than provide multiple cites to several columns of text with no explanation of how Fujimoto allegedly discloses the claimed limitations. Fujimoto itself is silent regarding any element similar to at least

¹³ Mailed August 19, 2011.

¹⁴ Mailed August 19, 2011.

the claimed computer and the claimed template program. Therefore, the claims include limitations not disclosed or suggested by the cited reference.

Furthermore, the May 25, 2011 Decision on Appeal concluded that a list of numbers, for questions already stored in the medical apparatus 8 of Fujimoto is similar to the claimed program, see findings of fact 5 in the May 25, 2011 Decision on Appeal. Assuming, *arguendo*, that the finding of fact 5 is correct (for which the Appellant's representative does not necessarily agree), Fujimoto is silent that the doctor enters the input data through a computer remotely located from the host computer 5. Fujimoto is silent that the list of numbers for the questions is generated by the host computer 5 in response to the input data received over telecommunication line 4. Fujimoto is also silent that the list of numbers for the questions is a modified version of a template program read from a database. The "medical side" mentioned in column 5 line 68-column 6 line 9 by the finding of fact 5 refers to the host computer 5 side of the telecommunication line 4 per column 2 lines 50-55 of Fujimoto. However, FIG. 1 of Fujimoto does not show another computer located on the host computer 5 side of the telecommunication line 4 that is in signal communication with the host computer 5 via the telecommunication line 4. Hence, the finding of fact 5 from the May 25, 2011 Decision on Appeal is no longer applicable to the presently pending claims. Therefore, the cited reference does not disclose or suggest (A) transmitting input data from the computer to the central processing unit via the communication network, (C) reading a template program from a database into the central processing unit and (D) generating a first program in the central processing unit by modifying the template program in response to the input data, as presently claimed.

Claim 77 further provides (F) transferring the first program from the central processing unit to a remote processing apparatus via the communication network and (H) executing the first program in the remote processing apparatus to collect measurement data from the measuring device. In contrast, the list of numbers in Fujimoto does not contain information necessary for the medical apparatus 8 to collect information from a measuring device, such as the medical terminal equipment 1 of Fujimoto. Instead, the program of Fujimoto appears to be nothing more than a list of numbers. One of ordinary skill in art would not understand a number to be an executable command. One of ordinary skill in the art would not appear to understand that a number can cause the medical apparatus 8 to collect data from the medical terminal equipment 1. Therefore, the claims include limitations not disclosed or suggested by the cited reference.

In particular, Fujimoto states that the questions for diagnosis inquiry are stored in advance in the medical terminal equipment 1 (see column 5 lines 64-66). It is these pre-loaded programs containing the questions that appear to be executed by the medical apparatus 8 of Fujimoto to present the questions to the patient. The list of numbers merely identifies which parts of the program are used. Therefore, Fujimoto teaches that the program executed by the medical apparatus 8 is “loaded in advance” instead of being downloaded from the host computer 5 via the telecommunication line 4.

Furthermore, the findings of fact 7 from the May 25, 2011 Decision on Appeal indicates that Fujimoto discloses a script program executing in the medical apparatus 8 to initiate collection of data from the attached medical terminal equipment 1. However, the finding of fact 7 is silent regarding the program in question being generated in the host apparatus 5 and then transfer

to the medical apparatus 8 over the telecommunication line 4. The finding of fact 7 and the finding of fact 5 appear to mention two different “programs”, one that initiates collection of data and the other which contains a list of numbers. The program from the finding of fact 5 does not initiate collection of data. On the other hand, the program from the finding of fact 7 appears to be a built-in capability of the medical apparatus 8. There is no reason why the medical terminal equipment 1 of Fujimoto would be built to measure blood pressure and pulse (see column 2 lines 36-38) and yet not have the necessary software to measure the blood pressure and pulse as part of the equipment. Therefore, the May 25, 2011 Decision on Appeal finding of fact 7 is not applicable to the presently pending claims. Fujimoto discloses a different configuration than as presently claimed. Therefore, the cited reference does not disclose or suggest (F) transferring the first program from the central processing unit to a remote processing apparatus via the communication network and (H) executing the first program in the remote processing apparatus to collect measurement data from the measuring device, as presently claimed.

In summary, Fujimoto does not explicitly or inherently disclose or suggest all three of the claimed (i) central processing unit, (ii) remote processing apparatus remotely located from and in signal communication with the central processing unit via the communication network and (iii) computer remotely located from and in signal communication with the central processing unit via the communication network. Fujimoto does not disclose or suggest (A) transmitting input data from the computer to the central processing unit via the communication network, (C) reading a template program from a database into the central processing unit and (D) generating a first program in the central processing unit by modifying the template program in response to the input data. Fujimoto

also fails to disclose or suggest (F) transferring the first program from the central processing unit to a remote processing apparatus via the communication network and (H) executing the first program in the remote processing apparatus to collect measurement data from the measuring device. No attempt is made by the Examiner to show that the missing elements are inherent to Fujimoto.

For the reasons presented above, claims 77 and 91 are independently patentable over the cited reference and the rejection should be reversed.

Claims 77 and 91 have been grouped and argued separately by Appellant as identified by the separate subheading under which the above arguments appear. Appellant respectfully requests that the Board provide explicit analysis and reasoning concerning the patentability of claim and the reasons why the rejection is (or is not) reversed.¹⁵

c. The rejection of claims 84 and 98 over Fujimoto is not sustainable and should be reversed.

Claim 84 of the present invention provides a method of monitoring a physiological condition of an individual using a communication network, the method comprising the steps of:

(A) transmitting input data from a computer to a central processing unit via the communication network, wherein the computer is remotely located from and in signal communication with the central processing unit via the communication network;

(B) transmitting input information from the computer to the central processing unit via the communication network;

¹⁵ MPEP §1205 and §1205.02.

(C) adding the input data received from the computer to a first program in the central processing to adapt the first program to the individual, wherein the first program collects blood glucose data relating to the physiological condition of the individual;

(D) assigning the first program to the individual in response to the input information;

(E) transmitting the first program from the central processing unit to the a remote processing apparatus via the communication network, wherein the remote processing apparatus is remotely located from and in signal communication with the central processing unit via the communication network;

(F) connecting the remote processing apparatus to a measuring device;

(G) executing the first program in the remote processing apparatus to collect the blood glucose data from the measuring device according to a collect command of the first program;

(H) transmitting the blood glucose data from the remote processing apparatus to the central processing unit through the communication network;

(I) transmitting the blood glucose data from the central processing unit to the computer via the communication network; and

(J) presenting a report generated based on the blood glucose data from the computer to a health care provider.

In contrast, the cited reference does not disclose or suggest all of the claimed limitations as arranged in the claims for the following reasons.

Claim 84 provides (i) a central processing unit, (ii) a remote processing apparatus remotely located from and in signal communication with the central processing unit via the communication network and (iii) a computer remotely located from and in signal communication with the central processing unit via the communication network. In contrast, Fujimoto is silent regarding all three types of machines on a communication network as provided in the claims. Therefore, the claims include limitations not disclosed or suggested by the cited reference.

In particular, FIG. 1 of Fujimoto illustrates a medical apparatus 8 connected to a host computer 5 via a telecommunication line 4. The Examiner asserts that the medical apparatus 8 of Fujimoto is similar to the claimed remote processing apparatus and the host computer 5 is similar to the claimed central processing unit. However, the Examiner does not identify any element of Fujimoto that is allegedly similar to the claimed computer. All that the Examiner cites in FIG. 1 is the entire FIG. 1 (see page 3 of the Office Action). However, FIG. 1 and the rest of Fujimoto are silent regarding another type of computer connected to the host computer 5 by way of the telecommunication line 4.

The May 25, 2011 Decision on Appeal asserted that a display unit sitting on top of the computer 5 is similar to the formerly claimed workstation, see finding of fact 10. The May 25, 2011 Decision on Appeal broadly interpreted the former claim term “workstation” to include the display unit of Fujimoto. Appellant did not agree with the broad interpretation, but in order to advance the prosecution, clarified that the claim provided a computer remotely located from and in signal communication with the central processing unit via the communication network. The display unit of Fujimoto itself is not a computer, it is not remotely located from the host computer 5 and it

is not in signal communication with the host computer 5 via the telecommunication line 4. Due to the amendment to the claim language, the display unit of Fujimoto does not disclose or suggested the claimed computer. As such, the May 25, 2011 Decision on Appeal finding of fact 10 is no longer applicable. The Examiner does not identify any element of Fujimoto allegedly similar to the claimed computer. Fujimoto itself is silent regarding a third element on the telecommunication line 4 and remotely located from the host computer 5 that could potentially be similar to the claimed computer. Therefore, the cited reference does not disclose or suggest (i) a central processing unit, (ii) a remote processing apparatus remotely located from and in signal communication with the central processing unit via the communication network and (iii) a computer remotely located from and in signal communication with the central processing unit via the communication network, as presently claimed.

Claim 84 further provides (A) transmitting input data from the computer to the central processing unit via the communication network and (C) adding the input data received from the computer to a first program in the central processing to adapt the first program to the individual, wherein the first program collects blood glucose data relating to the physiological condition of the individual. In contrast, the host computer 5 of Fujimoto does not add input data receive via the telecommunication line 4 to a first program to adapt the first program to the individual. Therefore, the claim includes limitations not disclosed or suggested by the cited reference.

The Examiner asserts that Fujimoto explicitly discloses the above claimed limitations in column 2 lines 32-55, column 4 lines 12-68, column 8 lines 8-39, column 9 line 10-column 10

line 10 (see Office Action¹⁶ page 3) and column 2 line 65-column 3 line 30 (see Office Action¹⁷ page 5). In contrast, none of the cites in Fujimoto provided by the Examiner mention a computer (other than the medical apparatus 8) sending the host computer 5 input data via the telecommunication line 4. None of the cites in Fujimoto provided by the Examiner mention the host computer 5 adding input data to a first program to adapt the first program to the individual. The Examiner has done no more than provide multiple cites to several columns of text with no explanation of how Fujimoto allegedly discloses the claimed limitations.

Furthermore, the claimed adding provided in step (C) is not found in claim 47. Hence, the Examiner's assertion (see the Office Action¹⁸ page 3) that claim 84 is "substantially similar to claims 47 and 55-57 and are therefore rejected in the same manner" is incomplete. Claim 84 contains limitations not found in claim 47 and so it was insufficient for anticipation for the Examiner to reject "in the same manner". Furthermore, Fujimoto itself is silent regarding any element similar to at least the claimed computer. Fujimoto is silent regarding the addition of input data to a first program. Fujimoto does not disclose collecting blood glucose data. Therefore, the claim includes limitations not disclosed or suggested by the cited reference.

Furthermore, the May 25, 2011 Decision on Appeal concluded that a list of numbers for questions already stored in the medical apparatus 8 of Fujimoto is similar to the claimed program, see findings of fact 5 in the May 25, 2011 Decision on Appeal. Assuming, *arguendo*, that the

¹⁶ Mailed August 19, 2011.

¹⁷ Mailed August 19, 2011.

¹⁸ Mailed August 19, 2011.

finding of fact 5 is correct (for which the Appellant's representative does not necessarily agree), Fujimoto is silent that the doctor enters the input data through a computer remotely located from the host computer 5. Fujimoto is silent that the alleged input data received over telecommunication line 4 is added to the list of numbers for the questions by the host computer 5. The "medical side" mentioned in column 5 line 68-column 6 line 9 by the finding of fact 5 refers to the host computer 5 side of the telecommunication line 4 per column 2 lines 50-55 of Fujimoto. However, FIG. 1 of Fujimoto does not show another computer located on the host computer 5 side of the telecommunication line 4 that is in signal communication with the host computer 5 via the telecommunication line 4. Hence, the finding of fact 5 from the May 25, 2011 Decision on Appeal is no longer applicable to the presently pending claims. Therefore, the cited reference does not disclose or suggest (A) transmitting input data from the computer to the central processing unit via the communication network and (C) adding the input data received from the computer to a first program in the central processing to adapt the first program to the individual, wherein the first program collects blood glucose data relating to the physiological condition of the individual, as presently claimed.

Claim 84 further provides (E) transmitting the first program from the central processing unit to the a remote processing apparatus via the communication network and (G) executing the first program in the remote processing apparatus to collect the blood glucose data from the measuring device according to a collect command of the first program. In contrast, the list of numbers in Fujimoto does not contain information necessary for the medical apparatus 8 to collect information from a measuring device, such as the medical terminal equipment 1 of Fujimoto.

Instead, the program of Fujimoto appears to be nothing more than a list of numbers. One of ordinary skill in art would not understand a number to be an executable command. One of ordinary skill in the art would not appear to understand that a number can cause the medical apparatus 8 to collect blood glucose data from the medical terminal equipment 1. Therefore, the claims include limitations not disclosed or suggested by the cited reference.

In particular, Fujimoto states that the questions for diagnosis inquiry are stored in advance in the medical terminal equipment 1 (see column 5 lines 64-66). It is these pre-loaded programs containing the questions that appear to be executed by the medical apparatus 8 of Fujimoto to present the questions to the patient. The list of numbers merely identifies which parts of the program are used. Therefore, Fujimoto teaches that the program executed by the medical apparatus 8 is “loaded in advance” instead of being downloaded from the host computer 5 via the telecommunication line 4.

Furthermore, the findings of fact 7 from the May 25, 2011 Decision on Appeal indicates that Fujimoto discloses a script program executing in the medical apparatus 8 to initiate collection of data from the attached medical terminal equipment 1. However, the finding of fact 7 is silent regarding the program in question being generated in the host apparatus 5 and then transfer to the medical apparatus 8 over the telecommunication line 4. The finding of fact 7 and the finding of fact 5 appear to mention two different “programs”, one that initiates collection of data and the other which contains a list of numbers. The program from the finding of fact 5 does not initiate collection of data. On the other hand, the program from the finding of fact 7 appears to be a built-in capability of the medical apparatus 8. There is no reason why the medical terminal equipment 1 of

Fujimoto would be built to measure blood pressure and pulse (see column 2 lines 36-38) and yet not have the necessary software to measure the blood pressure and pulse as part of the equipment. Therefore the May 25, 2011 Decision on Appeal finding of fact 7 is not applicable to the presently pending claims. Fujimoto discloses a different configuration than as presently claimed.

Regarding the claimed collect command in the first program, page 8 of the May 25, 2011 Decision on Appeal asserts that “by virtue of the inherent command characteristics of software, executing a command [is] part of the programming that causes the remote processing apparatus to transmit measurement data to the central processing unit.” Inherency requires certainty of results, not mere possibility.¹⁹ M.P.E.P. §2112 also requires the Office to provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. However, no basis in fact or technical reasoning have been provided by the Office. The Examiner also does not support the inherency argument. Therefore, the inherency argument is merely conclusory statement no longer supported by the Office and it should be withdrawn.

In particular, there is no certainty that list of numbers transferred from the host computer 5 to the medical apparatus 8 of Fujimoto includes a transmit command that necessarily causes measurement data to be transmitted back to the host computer 5. Other software, firmware and/or hardware built into the medical apparatus 8 could also cause the transmission. Therefore, the inherency argument on page 8 of the May 25, 2011 Decision on Appeal is in error and should be withdrawn. The Examiner does not support the inherency argument on page 8 of the May 25, 2011

¹⁹ See, e.g., *Ethyl Molded Products Co. v. Betts Package, Inc.*, 9 U.S.P.Q. 2d 1001 (E.D.Ky 1988). See also, *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (C.C.P.A. 1981).

Decision on Appeal. On page 5 of the Office Action,²⁰ the Examiner asserts that the “Office has carefully reviewed the decision mailed by the Board on May 25, 2011 and it has not found that the Board made any inherency arguments in their decision.” Consequently, the Examiner did not provide the basis in fact and/or technical reasoning to reasonably support the determination that the alleged inherent characteristic necessarily flows from the teaching of the applied prior art as required. The inherency argument appears to be withdrawn by the Examiner. Therefore, the cited reference does not disclose or suggest (E) transmitting the first program from the central processing unit to the a remote processing apparatus via the communication network and (G) executing the first program in the remote processing apparatus to collect the blood glucose data from the measuring device according to a collect command of the first program, as presently claimed.

In summary, Fujimoto does not explicitly or inherently disclose or suggest all three of the claimed (i) central processing unit, (ii) remote processing apparatus remotely located from and in signal communication with the central processing unit via the communication network and (iii) computer remotely located from and in signal communication with the central processing unit via the communication network. Fujimoto does not disclose or suggest (A) transmitting input data from the computer to the central processing unit via the communication network and (C) adding the input data received from the computer to a first program in the central processing to adapt the first program to the individual, wherein the first program collects blood glucose data relating to the physiological condition of the individual. Fujimoto does not disclose or suggest collecting blood glucose data. Fujimoto also fails to disclose or suggest (E) transmitting the first program from the central

²⁰ Mailed August 19, 2011.

processing unit to the a remote processing apparatus via the communication network and (G) executing the first program in the remote processing apparatus to collect the blood glucose data from the measuring device according to a collect command of the first program. No attempt is made by the Examiner to show that the missing elements are inherent to Fujimoto.

For the reasons presented above, claims 84 and 98 are independently patentable over the cited reference and the rejection should be reversed.

Claims 84 and 98 have been grouped and argued separately by Appellant as identified by the separate subheading under which the above arguments appear. Appellant respectfully requests that the Board provide explicit analysis and reasoning concerning the patentability of claim and the reasons why the rejection is (or is not) reversed.²¹

d. The rejection of claims 105 and 107-110 over Fujimoto is not sustainable and should be reversed.

Claims 105 and 107-110 depend, directly or indirectly, from claims 47, 77, 84, 91 and 98 respectively and, therefore, include all the limitations of associated claims 47, 77, 84, 91 and 98. Consequently, the arguments presented above in support of claims 47, 77, 84, 91 and 98 are hereby incorporated by reference in support of claims 105 and 107-110. However, these claims, in particular claim 105, recites a further limitation that the remote processing apparatus is configured to (i) intermittently establish a communication link with the central processing unit and (ii)

²¹ MPEP §1205 and §1205.02.

disconnect the communication link after a period of time after each establishment (see, for example, elements 328 and 334 in FIG. 12C).

The Examiner asserts on page 3 of the Office Action²² that claims 105 and 107-110 are “rejected in the same manner” as claims 47 and 55-57. In contrast, none of claims 47 and 55-57 provide the remote processing apparatus is configured to (i) intermittently establishing a communication link with the central processing unit and (ii) disconnecting the communication link after a period of time after each establishment. Due to the lack of any arguments on the merits of these claims, *prima facie* anticipation has not been established by the Examiner.

Furthermore, Fujimoto is silent regarding which machine, the host computer 5 and/or the medical apparatus 8 establishes a communication link, when (if ever) the communication link is disconnected and any intermittent re-connection. Column 8 lines 8-13 of Fujimoto simply mentions that the data is transmitted from user side to the medical institution side by means of a telephone line, CATV line or a radio channel. Fujimoto is silent regarding which side established a communication link across the telephone line, CATV line or radio channel. Fujimoto is silent regarding which side disconnects the communication link. Therefore, the claims include limitations not disclosed or suggested by the cited reference.

On page 12 of the May 25, 2011 Decision on Appeal, an argument was presented that communication between the host computer 5 and the medical apparatus 8 of Fujimoto is inherently intermittent and includes disconnecting the communication link. Inherency requires certainty of

²² Mailed August 19, 2011.

results, not mere possibility.²³ M.P.E.P. §2112 also requires the Office to provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. However, no basis in fact or technical reasoning have been provided by the Office. The Examiner also does not support the inherency argument. Therefore, the inherency argument is merely conclusory statement no longer support by the Office and it should be withdrawn.

In particular, there is no certainty that the medical apparatus 8 of Fujimoto establishes any communication link with the host computer 5. In contrast, it is possible that the host computer 5 of Fujimoto establishes a communication link. There is no certainty that the communication link is established intermittently. In contrast, it is possible that the communication link may remain open across the CATV line and/or the radio channel. There is no certainty that the communication link is disconnected after a period of time after each establishment. In contrast, if the communication link is disconnected, it may be disconnected after the data has been transmitted to the host computer 5 rather than some period of time after the communication link has been established. Therefore, the inherency argument on page 12 of the May 25, 2011 Decision on Appeal is in error and should be withdrawn. Furthermore, the Examiner does not support the inherency argument on page 12 of the May 25, 2011 Decision on Appeal. On page 5 of the Office Action,²⁴ the Examiner asserts that the "Office has carefully reviewed the decision mailed by the Board on May 25, 2011 and it has not found that the Board made any inherency arguments in their decision." Consequently, the Examiner

²³ See, e.g., *Ethyl Molded Products Co. v. Betts Package, Inc.*, 9 U.S.P.Q. 2d 1001 (E.D.Ky 1988). See also, *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (C.C.P.A. 1981).

²⁴ Mailed August 19, 2011.

did not provide the basis in fact and/or technical reasoning to reasonably support the determination that the alleged inherent characteristic necessarily flows from the teaching of the applied prior art as required. The inherency argument appears to be withdrawn by the Examiner. Therefore, the cited reference does not teach or suggest that the remote processing apparatus is configured to (i) intermittently establish a communication link with the central processing unit and (ii) disconnect the communication link after a period of time after each establishment, as presently claimed.

For the reasons presented above, claims 105 and 107-110 are independently patentable over the cited reference and the rejection should be reversed.

Claims 105 and 107-110 have been grouped and argued separately by Appellant as identified by the separate subheading under which the above arguments appear. Appellant respectfully requests that the Board provide explicit analysis and reasoning concerning the patentability of claim and the reasons why the rejection is (or is not) reversed.²⁵

B. 35 U.S.C. §103

As set forth on page 4 of the Office Action,²⁶ claims 48, 49, 51-54, 58-62, 78-83, 85-90, 92-97, 99-104 and 106 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Fujimoto.

In rejecting claims under 35 U.S.C. §103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d

²⁵ MPEP §1205 and §1205.02.

²⁶ Mailed August 19, 2011.

1071, 1073 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). “**All words in a claim must be considered** in judging the patentability of that claim against the prior art.”²⁷ “Under §103, the scope and content of the prior art are to be determined; **differences between the prior art and the claims at issue** are to be ascertained; and **the level of ordinary skill in the pertinent art** resolved. Against this background the obviousness or nonobviousness of the subject matter is to be determined. Such secondary considerations as commercial success, long felt by unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.”²⁸ “To facilitate review, **this analysis should be made explicit**. See *In re*²⁹ *Kahn*, 441 F.3d 977, 988 (CA Fed. 2006) (‘[R]ejections on obviousness grounds cannot be sustained by mere conclusory statement; instead, there must be **some articulated reasoning with some rational underpinning** to support the legal conclusion of obviousness’).”³⁰

“If the Examiner does not produce a *prima facie* case, the Applicant is under no obligation to submit evidence of non-obviousness.”³¹ If the Examiner’s burden is met, the burden then shifts to the Appellant to overcome the *prima facie* case with argument and/or evidence.

²⁷ Manual of Patent Examining Procedure (M.P.E.P.), Eighth Edition, Rev. 8, July 2010, §2143.03 (emphasis added).

²⁸ *KSR International Co. v. Teleflex Inc., et al.* 82 USPQ2d 1385 (2007) citing *Graham v. John Deere Co. Of Kansas City*, 383 U.S. 1 (1966).

³⁰ *KSR International Co.*, 82 USPQ2d 1385 at 1396 (emphasis added).

³¹ M.P.E.P. §2142.

Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments.³² As explained herein below, because Fujimoto does not teach each and every element of the claims, the claimed invention is patentable over the cited reference and the rejections should be reversed.

1. Claims 48, 49, 51-54, 58-62, 78-83, 85-90, 92-97, 99-104 and 106 are patentable over Fujimoto.

As set forth on page 4 of the final Office Action,³³ claims 48, 49, 51-54, 58-62, 78-83, 85-90, 92-97, 99-104 and 106 are rejected under 35 U.S.C. § 103(a) as being unpatentable over US Patent Number 5,339,821 to Fujimoto as applied to claim 47.

Claims 48, 49, 51-54, 58-62, 78-83, 85-90, 92-97, 99-104 and 106 do not stand or fall together. Rather, claims 59 and 60 (Group I), claims 49 and 61 (Group II), claims 80, 87, 94 and 101 (Group III), claims 82 and 96 (Group IV), claims 90 and 104 (Group V), claim 106 (Group VI), claims 51 and 62 (Group VII) and claims 48, 52-54, 58, 78, 79, 81, 83, 85, 86, 88, 89, 92, 93, 95, 97, 99, 100, 102 and 103 (Group VIII) are argued separately.

a. The rejection of claims 59 and 60 over Fujimoto is not sustainable and should be reversed.

Claim 59 of the present invention provides a system for monitoring a physiological condition of an individual using a communication network, comprising:

³² See *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

³³ Mailed August 19, 2011.

a central processing unit (A) having access to one or more databases and (B) configured to (i) generate a first program that collects blood glucose data relating to the physiological condition of the individual, (ii) add input data received from the communication network to the first program to adapt the first program to the individual, (iii) assign the first program to the individual in response to input information received from the communication network and (iv) transmit the first program via the communication network;

a remote processing apparatus remotely located from and in signal communication with the central processing unit via the communication network, wherein the remote processing apparatus is configured to (i) receive the first program from the communication network, (ii) connect to a measuring device, (iii) execute the first program to collect the blood glucose data according to a collect command in the first program and (iv) transmit the blood glucose data to the central processing unit via the communication network; and

a computer remotely located from and in signal communication with the central processing unit via the communication network, wherein the computer is configured to (i) transmit the input data to the central processing unit via the communication network, (ii) transmit the input information to the central processing unit via the communication network, (iii) receive the blood glucose data from the central processing unit via the communication network and (iv) present a report generated based on the blood glucose data to a health care provider.

In contrast, the cited reference does not teach or suggest all of the claimed limitations for the following reasons.

Claim 59 provides (i) a central processing unit, (ii) a remote processing apparatus remotely located from and in signal communication with the central processing unit via the communication network and (iii) a computer remotely located from and in signal communication with the central processing unit via the communication network. In contrast, Fujimoto is silent regarding all three types of machines on a communication network as provided in the claims. Therefore, the claims include limitations not taught or suggested by the cited reference.

In particular, FIG. 1 of Fujimoto illustrates a medical apparatus 8 connected to a host computer 5 via a telecommunication line 4. The Examiner asserts that the medical apparatus 8 of Fujimoto is similar to the claimed remote processing apparatus and the host computer 5 is similar to the claimed central processing unit. However, the Examiner does not identify any element of Fujimoto that is allegedly similar to the claimed computer. All that the Examiner cites in FIG. 1 is the entire FIG. 1 (see pages 3 and 4 of the Office Action). However, FIG. 1 and the rest of Fujimoto are silent regarding another type of computer connected to the host computer 5 by way of the telecommunication line 4.

The May 25, 2011 Decision on Appeal asserted that a display unit sitting on top of the computer 5 is similar to the formerly claimed workstation, see finding of fact 10. The May 25, 2011 Decision on Appeal broadly interpreted the former claim term “workstation” to include the display unit of Fujimoto. Appellant did not agree with the broad interpretation, but in order to advance the prosecution, clarified that the claim provided a computer remotely located from and in signal communication with the central processing unit via the communication network. The display unit of Fujimoto itself is not a computer, it is not remotely located from the host computer 5 and it

is not in signal communication with the host computer 5 via the telecommunication line 4. Due to the amendment to the claim language, the display unit of Fujimoto does not teach or suggested the claimed computer. As such, the May 25, 2011 Decision on Appeal finding of fact 10 is no longer applicable. The Examiner does not identify any element of Fujimoto allegedly similar to the claimed computer. Fujimoto itself is silent regarding a third element on the telecommunication line 4 and remotely located from the host computer 5 that could potentially be similar to the claimed computer. Therefore, the cited reference does not teach or suggest (i) a central processing unit, (ii) a remote processing apparatus remotely located from and in signal communication with the central processing unit via the communication network and (iii) a computer remotely located from and in signal communication with the central processing unit via the communication network, as presently claimed.

Claim 59 further provides that the computer is configured to (i) transmit the input data to the central processing unit via the communication network and the central processing unit is configured to (i) generate a first program that collects blood glucose data relating to the physiological condition of the individual and (ii) add input data received from the communication network to the first program to adapt the first program to the individual. In contrast, the host computer 5 of Fujimoto does not add input data received via the telecommunication line 4 to a first program that collects blood glucose data. Therefore, the claim includes limitations not disclosed or suggested by the cited reference.

The Examiner asserts that Fujimoto explicitly discloses the above claimed limitations in column 2 lines 32-55, column 4 lines 12-68, column 8 lines 8-39, column 9 line 10-column 10

line 10 (see Office Action³⁴ pages 3 and 5) and column 2 line 65-column 3 line 30 (see Office Action³⁵ page 5). In contrast, none of the cites in Fujimoto provided by the Examiner mention a computer (other than the medical apparatus 8) sending the host computer 5 input data via the telecommunication line 4. None of the cites in Fujimoto provided by the Examiner mention the host computer 5 adding input data to a first program. The Examiner has done no more that provide multiple cites to several columns of text with no explanation of how Fujimoto allegedly teaches the claimed limitations.

Furthermore, the claimed adding of the input data to the first program is not found in claim 47. Hence, the Examiner's assertion (see the Office Action³⁶ page 5) that claim 59 is "substantially similar to claims 47 and 55-57 and are therefore rejected in the same manner" is incomplete. Claim 59 contains limitations not found in claim 47 and so it was insufficient for obviousness for the Examiner to reject "in the same manner". Furthermore, Fujimoto itself is silent regarding any element similar to at least the claimed computer. Fujimoto is silent regarding the addition of input data to a first program. Fujimoto does not disclose collecting blood glucose data. Therefore, the claim includes limitations not taught or suggested by the cited reference.

Furthermore, the May 25, 2011 Decision on Appeal concluded that a list of numbers, for questions already stored in the medical apparatus 8 of Fujimoto is similar to the claimed program, see in the May 25, 2011 Decision on Appeal. Assuming, *arguendo*, that the finding of fact 5 is

³⁴ Mailed August 19, 2011.

³⁵ Mailed August 19, 2011.

³⁶ Mailed August 19, 2011.

correct (for which the Appellant's representative does not necessarily agree), Fujimoto is silent that the doctor enters the input data through a computer remotely located from the host computer 5. Fujimoto is silent that the alleged input data received over telecommunication line 4 is added to the list of numbers for the questions by the host computer 5. The "medical side" mentioned in column 5 line 68-column 6 line 9 by the finding of fact 5 refers to the host computer 5 side of the telecommunication line 4 per column 2 lines 50-55 of Fujimoto. However, FIG. 1 of Fujimoto does not show another computer located on the host computer 5 side of the telecommunication line 4 that is in signal communication with the host computer 5 via the telecommunication line 4. Hence, the finding of fact 5 from the May 25, 2011 Decision on Appeal is no longer applicable to the presently pending claims. Therefore, the cited reference does not teach or suggest that the computer is configured to (i) transmit the input data to the central processing unit via the communication network and the central processing unit is configured to (i) generate a first program that collects blood glucose data relating to the physiological condition of the individual and (ii) add input data received from the communication network to the first program to adapt the first program to the individual, as presently claimed.

Claim 59 further provides that the central processing unit is configured to (iv) transmit the first program via the communication network and the remote processing apparatus configured to execute the first program to collect blood glucose data according to a collect command contained in the first program. In contrast, the list of numbers in Fujimoto does not contain information necessary for the medical apparatus 8 to collect blood glucose from a measuring device, such as the medical terminal equipment 1 of Fujimoto. Instead, the program of Fujimoto appears

to be nothing more than a list of numbers. One of ordinary skill in art would not understand a number to be an executable command. One of ordinary skill in the art would not appear to understand that a number can cause the medical apparatus 8 to collect data from the medical terminal equipment 1. Therefore, the claims include limitations not taught or suggested by the cited reference.

In particular, Fujimoto states that the questions for diagnosis inquiry are stored in advance in the medical terminal equipment 1 (see column 5 lines 64-66). It is these pre-loaded programs containing the questions that appear to be executed by the medical apparatus 8 of Fujimoto to present the questions to the patient. The list of numbers merely identifies which parts of the program are used. Therefore, Fujimoto teaches that the program executed by the medical apparatus 8 is "loaded in advance" instead of being downloaded from the host computer 5 via the telecommunication line 4.

Furthermore, the findings of fact 7 from the May 25, 2011 Decision on Appeal indicates that Fujimoto discloses a script program executing in the medical apparatus 8 to initiate collection of data from the attached medical terminal equipment 1. However, the finding of fact 7 is silent regarding the program in question being generated in the host apparatus 5 and then transfer to the medical apparatus 8 over the telecommunication line 4. The finding of fact 7 and the finding of fact 5 appear to mention two different "programs", one that initiates collection of data and the other which contains a list of numbers. The program from the finding of fact 5 does not contain not commands to initiate collection of data. On the other hand, the program from the finding of fact 7 appears to be a built-in capability of the medical apparatus 8. There is no reason why the medical

terminal equipment 1 of Fujimoto would be built to measure blood pressure and pulse (see column 2 lines 36-38) and yet not have the necessary software to measure the blood pressure and pulse as part of the equipment. Therefore the May 25, 2011 Decision on Appeal finding of fact 7 is not applicable to the presently pending claims. Fujimoto discloses a different configuration than as presently claimed.

Regarding the claimed collect command in the first program, page 8 of the May 25, 2011 Decision on Appeal asserts that “by virtue of the inherent command characteristics of software, executing a command [is] part of the programming that causes the remote processing apparatus to transmit measurement data to the central processing unit.” Inherency requires certainty of results, not mere possibility.³⁷ M.P.E.P. §2112 also requires the Office to provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. However, no basis in fact or technical reasoning have been provided by the Office. The Examiner also does not support the inherency argument. Therefore, the inherency argument is merely conclusory statement no longer support by the Office and it should be withdrawn.

In particular, there is no certainty that list of numbers transferred from the host computer 5 to the medical apparatus 8 of Fujimoto includes a transmit command that necessarily causes measurement data to be transmitted back to the host computer 5. Other software, firmware and/or hardware built into the medical apparatus 8 could also cause the transmission. Therefore, the inherency argument on page 8 of the May 25, 2011 Decision on Appeal is in error and should be

³⁷ See, e.g., *Ethyl Molded Products Co. v. Betts Package, Inc.*, 9 U.S.P.Q. 2d 1001 (E.D.Ky 1988). See also, *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (C.C.P.A. 1981).

withdrawn. The Examiner does not support the inherency argument on page 8 of the May 25, 2011 Decision on Appeal. On page 5 of the Office Action,³⁸ the Examiner asserts that the “Office has carefully reviewed the decision mailed by the Board on May 25, 2011 and it has not found that the Board made any inherency arguments in their decision.” Consequently, the Examiner did not provide the basis in fact and/or technical reasoning to reasonably support the determination that the alleged inherent characteristic necessarily flows from the teaching of the applied prior art as required. The inherency argument appears to be withdrawn by the Examiner. Therefore, the cited reference does not teach or suggest that the central processing unit is configured to (iv) transmit the first program via the communication network and the remote processing apparatus configured to execute the first program to collect blood glucose data according to a collect command contained in the first program, as presently claimed.

In summary, Fujimoto does not explicitly or inherently teach or suggest all three of the claimed (i) central processing unit, (ii) remote processing apparatus remotely located from and in signal communication with the central processing unit via the communication network and (iii) computer remotely located from and in signal communication with the central processing unit via the communication network. Fujimoto does not teach or suggest that the computer is configured to (i) transmit the input data to the central processing unit via the communication network and the central processing unit is configured to (i) generate a first program that collects blood glucose data relating to the physiological condition of the individual and (ii) add input data received from the communication network to the first program to adapt the first program to the individual. Fujimoto

³⁸ Mailed August 19, 2011.

also fails to teach or suggest that the central processing unit is configured to (iv) transmit the first program via the communication network and the remote processing apparatus configured to execute the first program to collect blood glucose data according to a collect command contained in the first program. No attempt is made by the Examiner to show that the missing elements are inherent to Fujimoto.

For the reasons presented above, claims 59 and 60 are independently patentable over the cited reference and the rejection should be reversed.

Claims 59 and 60 have been grouped and argued separately by Appellant as identified by the separate subheading under which the above arguments appear. Appellant respectfully requests that the Board provide explicit analysis and reasoning concerning the patentability of claim and the reasons why the rejection is (or is not) reversed.³⁹

b. The rejection of claims 49 and 61 over Fujimoto is not sustainable and should be reversed.

Claims 49 and 61 depend, either directly or indirectly, from claims 47 and 59 respectively and, therefore, includes all the limitations of associated claims 47 and 59. Consequently, the arguments presented above in support of claims 47 and 59 are hereby incorporated by reference in support of claims 49 and 61. However, these claims, in particular claim 49, recite further limitations that the computer is further configured to (i) receive the input information from

³⁹ MPEP §1205 and §1205.02.

the health care provider and (ii) communicate the input information to the central processing unit (see, for example, element 202 in FIG. 11A).

In contrast, Fujimoto is silent regarding a computer in signal communication on the telecommunication line 4 that receives input information from a health care provider and communicates the input information to the host computer 5. On page 4 of the Office Action,⁴⁰ the Examiner defers to the rationale provided in the May 25, 2011 Decision on Appeal, even though the claims were amended since that decision. Since the Examiner does not address the actual language of the claims, *prima facie* obviousness has not been established. As such, Appellant is under no obligation to submit evidence of non-obviousness.

Furthermore, page 15 of May 25, 2011 Decision on Appeal asserts that it is inherent that Fujimoto includes the necessary peripherals and programming that meet the claimed limitations. Inherency requires certainty of results, not mere possibility.⁴¹ M.P.E.P. §2112 also requires the Office to provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. However, no basis in fact or technical reasoning have been provided by the Office. The Examiner also does not support the inherency argument. Therefore, the inherency argument is merely conclusory statement no longer supported by the Office and it should be withdrawn.

In particular, there is no certainty that the peripherals of the host computer 5 contain software that (i) receives input information from the health care provider and (ii) communicates the

⁴⁰ Mailed August 19, 2011.

⁴¹ See, e.g., *Ethyl Molded Products Co. v. Betts Package, Inc.*, 9 U.S.P.Q. 2d 1001 (E.D.Ky 1988). See also, *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (C.C.P.A. 1981).

input information to the host computer 5. In particular, the display and printer 6 illustrated in FIG. 1 of Fujimoto are output devices that do not receive input information from a health care provider. The keyboard illustrated in FIG. 1 of Fujimoto does not contain any software. Therefore, the inherency argument on page 15 of the May 25, 2011 Decision on Appeal is in error and should be withdrawn. The Examiner does not support the inherency argument on page 15 of the May 25, 2011 Decision on Appeal. On page 5 of the Office Action⁴², the Examiner asserts that the "Office has carefully reviewed the decision mailed by the Board on May 25, 2011 and it has not found that the Board made any inherency arguments in their decision." Consequently, the Examiner did not provide the basis in fact and/or technical reasoning to reasonably support the determination that the alleged inherent characteristic necessarily flows from the teaching of the applied prior art as required. The inherency argument appears to be withdrawn by the Examiner. Therefore, the cited reference does not teach or suggest that the computer is further configured to (i) receive the input information from the health care provider and (ii) communicate the input information to the central processing unit, as presently claimed.

For the reasons presented above, claims 49 and 61 are independently patentable over the cited reference and the rejection should be reversed.

Claims 49 and 61 have been grouped and argued separately by Appellant as identified by the separate subheading under which the above arguments appear. Appellant respectfully requests

⁴² Mailed August 19, 2011.

that the Board provide explicit analysis and reasoning concerning the patentability of claim and the reasons why the rejection is (or is not) reversed.⁴³

c. The rejection of claims 80, 87, 94 and 101 over Fujimoto is not sustainable and should be reversed.

Claims 80, 87, 94 and 101 depend, either directly or indirectly, from claims 77, 84, 91 and 98 respectively and, therefore, includes all the limitations of associated claims 77, 84, 91 and 98. Consequently, the arguments presented above in support of claims 77, 84, 91 and 98 are hereby incorporated by reference in support of claims 80, 87, 94 and 101. However, these claims, in particular claim 80, recite further limitation of transmitting the report to the computer via the communication network. (see, for example, element 58 in FIG. 2).

In contrast, Fujimoto is silent regarding a computer in signal communication on the telecommunication line 4 that receives a report via the telecommunication line 4 from the host computer 5. On page 4 of the Office Action⁴⁴, the Examiner defers to the rationale provided in the May 25, 2011 Decision on Appeal, even though the claims were amended since that decision. Since the Examiner does not address the actual language of the claims, *prima facie* obviousness has not been established. As such, Appellant is under no obligation to submit evidence of non-obviousness.

⁴³ MPEP §1205 and §1205.02.

⁴⁴ Mailed August 19, 2011.

Furthermore, page 16 of May 25, 2011 Decision on Appeal argues that the host computer 5 of Fujimoto displays a report on its own display unit. The May 25, 2011 Decision on Appeal does not present any arguments that the host computer 5 transmits the report across the telecommunications line 4 to another computer because the claims were different at that time. Hence, the arguments presented against claims 80, 87, 94 and 101 in the May 25, 2011 Decision on Appeal are inapplicable to the current pending claims and should be disregarded. Therefore, the cited reference does not teach or suggest transmitting the report to the computer via the communication network, as presently claimed.

For the reasons presented above, claims 80, 87, 94 and 101 are independently patentable over the cited reference and the rejection should be reversed.

Claims 80, 87, 94 and 101 have been grouped and argued separately by Appellant as identified by the separate subheading under which the above arguments appear. Appellant respectfully requests that the Board provide explicit analysis and reasoning concerning the patentability of claim and the reasons why the rejection is (or is not) reversed.⁴⁵

d. The rejection of claims 82 and 96 over Fujimoto is not sustainable and should be reversed.

Claims 82 and 96 depend, directly or indirectly, from claims 77 and 92 respectively and, therefore, includes all the limitations of associated claims 77 and 92. Consequently, the arguments presented above in support of claims 77 and 92 are hereby incorporated by reference in

⁴⁵ MPEP §1205 and §1205.02.

support of claims 82 and 96. However, these claims, in particular claim 82, recites a further limitation of collecting the measurement data at the remote processing apparatus from the measuring device according to a collect command of the first program (see, for example, the COLLECT command in Table 1).

The Examiner asserts on page 5 of the Office Action⁴⁶ that claims 82 and 96 are rejected “in the same manner” as claims 60-62. In contrast, claims 60-62 do not include a limitation of collecting the measurement data at the remote processing apparatus from the measuring device according to a collect command of the first program. Therefore, *prima facie* obviousness has not been established.

Furthermore, Fujimoto is silent that the list of numbers sent to the medical apparatus 8 includes a particular number reserved as a collect command to collect the measurement data from the measuring device. Therefore, the claims include limitations not taught or suggested by the cited reference.

Furthermore, page 14 of the May 25, 2011 Decision on Appeal adopts the cite into Fujimoto provided in the March 18, 2008 Examiner’s Answer. The March 18, 2008 Examiner’s Answer cites column 8 lines 8-39 of Fujimoto in rejecting claim 82. The cited text of Fujimoto states that the data may be transmitted from the user side to the medical institution side by means of a telephone line, a CATV line or a radio channel. However, nothing in the cited text or the rest of Fujimoto mentions that the collection of the data is due to a collection command in the list of numbers sent to the medical apparatus 8. Nothing in Fujimoto explain how a list of number that

⁴⁶ Mailed August 19, 2011.

identify what questions to ask the patient allegedly cause a measurement of the blood pressure data. Fujimoto does show an armband 10 connected to the medical apparatus 8 in FIG. 4. However, FIG. 5 of Fujimoto shows that measurements taken from the armband 10 are initiated by the patient by pressing a button (OPERATION BUTTON (Yes) ON). A similar manual procedure is mentioned in column 5, lines 14-61 of Fujimoto using EKG electrodes 18 per the flow diagram of FIG. 6. The rest of Fujimoto appears to be silent regarding any type of collect command within a program previously generated in the host computer 5 and transferred to the medical apparatus 8. Therefore, the cited reference does not teach or suggest collecting the measurement data at the remote processing apparatus from the measuring device according to a collect command of the first program, as presently claimed.

For the reasons presented above, claims 82 and 96 are independently patentable over the cited reference and the rejection should be reversed.

Claims 82 and 96 have been grouped and argued separately by Appellant as identified by the separate subheading under which the above arguments appear. Appellant respectfully requests that the Board provide explicit analysis and reasoning concerning the patentability of claim and the reasons why the rejection is (or is not) reversed.⁴⁷

⁴⁷ MPEP §1205 and §1205.02.

e. The rejection of claims 90 and 104 over Fujimoto is not sustainable and should be reversed.

Claims 90 and 104 depend, directly or indirectly, from claims 85 and 99 respectively and, therefore, includes all the limitations of associated claims 85 and 99. Consequently, the arguments presented above in support of claims 85 and 99 are hereby incorporated by reference in support of claims 90 and 104. However, these claims, in particular, claim 90 recites a further limitation of transmitting of the blood glucose data from the remote processing apparatus to the central processing unit is according to a transmit command of the first program (see, for example, the element 330 in FIG. 12C).

The Examiner asserts on page 5 of the Office Action⁴⁸ that claims 90 and 104 are rejected “in the same manner” as claims 60-62. In contrast, claims 60-62 do not include a limitation of transmitting of the blood glucose data from the remote processing apparatus to the central processing unit is according to a transmit command of the first program. Therefore, *prima facie* obviousness has not been established.

Furthermore, Fujimoto is silent that the list of numbers send to the medical apparatus 8 includes a particular number reserved as a transmit command to send the measurement data from the medical apparatus 8 to the host computer 5. Therefore, the claims include limitations not taught or suggested by the cited reference.

Furthermore, page 14 of the May 25, 2011 Decision on Appeal adopts the cite into Fujimoto provided in the March 18, 2008 Examiner’s Answer. The March 18, 2008 Examiner’s

⁴⁸ Mailed August 19, 2011.

Answer cites column 8 lines 8-39 of Fujimoto in rejecting claim 90. The cited text of Fujimoto states that the data may be transmitted from the user side to the medical institution side by means of a telephone line, a CATV line or a radio channel. However, nothing in the cited text or the rest of Fujimoto mentions that the transmission of the data is due to a transmit command in the list of numbers sent to the medical apparatus 8. Nothing in Fujimoto explains how a list of number that identify what questions to ask the patient allegedly cause a transmission of the blood pressure data on the telecommunication line 4. The rest of Fujimoto appears to be silent regarding any type of transmit command within a program previously generated in the host computer 5 and transferred to the medical apparatus 8. Therefore, the cited reference does not teach or suggest transmitting of the blood glucose data from the remote processing apparatus to the central processing unit is according to a transmit command of the first program, as presently claimed.

For the reasons presented above, claims 90 and 104 are independently patentable over the cited reference and the rejection should be reversed.

Claims 90 and 104 have been grouped and argued separately by Appellant as identified by the separate subheading under which the above arguments appear. Appellant respectfully requests that the Board provide explicit analysis and reasoning concerning the patentability of claim and the reasons why the rejection is (or is not) reversed.⁴⁹

⁴⁹ MPEP §1205 and §1205.02.

f. The rejection of claim 106 over Fujimoto is not sustainable and should be reversed.

Claim 106 depends directly from claim 59 and, therefore, includes all the limitations of claim 59. Consequently, the arguments presented above in support of claim 59 are hereby incorporated by reference in support of claim 106. However, claim 106 recites a further limitation that the remote processing apparatus is configured to intermittently establish a communication link with the central processing unit and (ii) disconnect the communication link after a period of time after each establishment (see, for example, elements 328 and 334 in FIG. 12C).

The Examiner asserts on page 4 of the Office Action⁵⁰ that claim 106 is rejected in the same manner as set for the in the May 25, 2011 Decision on Appeal. Page 14 of the May 25, 2011 Decision on Appeal adopts the rejection provided in the March 18, 2008 Examiner's Answer. Page 8 of the March 18, 2008 Examiner's Answer asserts that communication between the host computer 5 and the medical apparatus 8 of Fujimoto is inherently intermittent and includes disconnecting the communication link. Inherency requires certainty of results, not mere possibility.⁵¹ M.P.E.P. §2112 also requires the Office to provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. The only technical basis provided by the Examiner is that a telephone normally can only handle a very limited number of links. However, no explanation is provided why a telephone line necessarily cannot be dedicated to a single link. No explanation is

⁵⁰ Mailed August 19, 2011.

⁵¹ See, e.g., *Ethyl Molded Products Co. v. Betts Package, Inc.*, 9 U.S.P.Q. 2d 1001 (E.D.Ky 1988). See also, *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (C.C.P.A. 1981).

provided why the CATV line or radio channel must have similar limitations. Therefore, the inherency argument is merely conclusory statement and it should be withdrawn.

In particular, there is no certainty that the medical apparatus 8 of Fujimoto establishes any communication link with the host computer 5. In contrast, it is possible that the host computer 5 of Fujimoto establishes a communication link. There is no certainty that the communication link is established intermittently. In contrast, it is possible that the communication link may remain open across the CATV line and/or the radio channel. There is no certainty that the communication link is disconnected after a period of time after each establishment. In contrast, if the communication link is disconnected, it may be disconnected after the data has been transmitted to the host computer 5 rather than some period of time after the communication link has been established. Therefore, the inherency argument on page 8 of the March 18, 2008 Examiner's Answer is in error and should be withdrawn. Therefore, the cited reference does not teach or suggest that the remote processing apparatus is configured to (i) intermittently establish a communication link with the central processing unit and (ii) disconnect the communication link after a period of time after each establishment, as presently claimed.

For the reasons presented above, claim 106 is independently patentable over the cited reference and the rejection should be reversed.

Claim 106 has been grouped and argued separately by Appellant as identified by the separate subheading under which the above arguments appear. Appellant respectfully requests that

the Board provide explicit analysis and reasoning concerning the patentability of claim and the reasons why the rejection is (or is not) reversed.⁵²

g. The rejection of claims 51 and 62 over Fujimoto is not sustainable and should be reversed.

Claims 51 and 62 depend, either directly or indirectly, from claims 47 and 59 respectively and, therefore, includes all the limitations of associated claims 47 and 59. Consequently, the arguments presented above in support of claims 47 and 59 are hereby incorporated by reference in support of claims 51 and 62. However, these claims, in particular claim 51, recite further limitation that (i) the central processing unit is further configured to generate the report based on the blood glucose data and (ii) transmit the report to the computer via the communication network (see, for example, element 58 in FIG. 2).

In contrast, Fujimoto is silent regarding a computer in signal communication on the telecommunication line 4 that receives a report via the telecommunication line 4 from the host computer 5. On page 4 of the Office Action⁵³, the Examiner defers to the rationale provided in the May 25, 2011 Decision on Appeal, even though the claims were amended since that decision. Since the Examiner does not address the actual language of the claims, *prima facie* obviousness has not been established. As such, Appellant is under no obligation to submit evidence of non-obviousness.

⁵² MPEP §1205 and §1205.02.

⁵³ Mailed August 19, 2011.

Page 14 of May 25, 2011 Decision on Appeal defers to the March 18, 2008 Examiner's Answer for the rejection of claims 51 and 62. However, the March 18, 2008 Examiner's Answer was written to a version of the claims without the transmitting of the report to the computer via the communication network. Thus, none of the March 18, 2008 Examiner's Answer, the May 25, 2011 Decision on Appeal nor the Office Action⁵⁴ address all of the claimed limitations. Therefore, the cited reference does not teach or suggest that (i) the central processing unit is further configured to generate the report based on the blood glucose data and (ii) transmit the report to the computer via the communication network, as presently claimed.

For the reasons presented above, claims 51 and 62 are independently patentable over the cited reference and the rejection should be reversed.

Claims 51 and 62 have been grouped and argued separately by Appellant as identified by the separate subheading under which the above arguments appear. Appellant respectfully requests that the Board provide explicit analysis and reasoning concerning the patentability of claim and the reasons why the rejection is (or is not) reversed.⁵⁵

⁵⁴ Mailed August 19, 2011.

⁵⁵ MPEP §1205 and §1205.02.

- h. The rejection of claims 48, 52-54, 58, 78, 79, 81, 83, 85, 86, 88, 89, 92, 93, 95, 97, 99, 100, 102 and 103 over Fujimoto is not sustainable and should be reversed.**

Claims 48, 52-54, 58, 78, 79, 81, 83, 85, 86, 88, 89, 92, 93, 95, 97, 99, 100, 102 and 103 depend, either directly or indirectly, from claims 47 and 59 respectively and, therefore, includes all the limitations of associated claims 47, 77, 84, 91 and 98. Consequently, the arguments presented above in support of claims 47, 77, 84, 91 and 98 are hereby incorporated by reference in support of claims 48, 52- 54, 58, 78, 79, 81, 83, 85, 86, 88, 89, 92, 93, 95, 97, 99, 100, 102 and 103. For the reasons presented above, the claims are independently patentable over the cited reference and the rejections should be reversed.

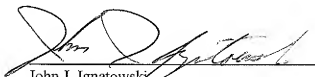
C. CONCLUSION

The cited reference does not suggest (i) a central processing unit, (ii) a remote processing apparatus remotely located from and in signal communication with the central processing unit via the communication network and (iii) a computer remotely located from and in signal communication with the central processing unit via the communication network as recited in the independent claims. Hence, the Examiner has clearly erred with respect to the patentability of the claimed invention. It is respectfully requested that the Board overturn the Examiner's rejection of all pending claims, and hold that the claims are not rendered anticipated and/or obvious by the cited reference. However, should the Board find the arguments herein in support of independent claims

47, 59, 77, 84, 91 and /or 98 unpersuasive, the Board is respectfully requested to carefully consider the arguments set forth above in support of each of the independently patentable groups.

Respectfully submitted,

CHRISTOPHER P. MAIORANA, P.C.

A handwritten signature in black ink, appearing to read "John J. Ignatowski", is written over a horizontal line.

John J. Ignatowski
Registration No. 36,555
Phone No. (586) 498-0670

Dated: March 19, 2012

c/o Health Hero Network

G:\HealthHero\7553\00055\APPEAL-brf2.wpd

VIII. CLAIM APPENDIX

The claims of the present application which are involved in this appeal are as follows:

1 47. A system for monitoring a physiological condition of an individual using a
2 communication network, comprising:

3 a central processing unit (A) having access to one or more databases and (B)
4 configured to (i) read a template program from the database, (ii) generate a first program by
5 modifying the template program in response to input data received via the communication network,
6 wherein the first program collects measurement data relating to the physiological condition of the
7 individual, (iii) assign the first program to the individual in response to input information received
8 from the communication network and (iv) transmit the first program via the communication network;

9 a remote processing apparatus remotely located from and in signal communication
10 with the central processing unit via the communication network, wherein the remote processing
11 apparatus is configured to (i) receive the first program from the communication network, (ii) connect
12 to a measuring device, (iii) execute the first program to collect the measurement data according to
13 a collect command contained in the first program and (iv) transmit the measurement data to the
14 central processing unit via the communication network according to a transmit command contained
15 in the first program; and

16 a computer remotely located from and in signal communication with the central
17 processing unit via the communication network, wherein the computer is configured to (i) transmit
18 the input data to the central processing unit via the communication network, (ii) transmit the input

19 information to the central processing unit via the communication network, (iii) receive the
20 measurement data from the central processing unit via the communication network and (iv) present
21 a report generated based on the measurement data to a health care provider.

1 48. The system of claim 47, wherein the physiological condition comprises
2 diabetes, the measuring device comprises a blood glucose measurement device and the measurement
3 data comprises blood glucose data.

1 49. The system of claim 47, wherein the computer is further configured to (i)
2 receive the input information from the health care provider and (ii) communicate the input
3 information to the central processing unit.

1 51. The system of claim 48, wherein (i) the central processing unit is further
2 configured to generate the report based on the blood glucose data and (ii) transmit the report to the
3 computer via the communication network.

1 52. The system of claim 47, wherein the remote processing apparatus comprises
2 a processor configured to execute the first program.

1 53. The system of claim 47, wherein the generating and assigning of the first
2 program comprises appending a unique patient identification code associated with the individual to
3 the first program.

1 54. The system of claim 47, wherein (i) the central processing unit is further
2 configured to store the first program in the database, (ii) the assignment of the first program
3 comprises generating a pointer to the first program related to the individual based on the input
4 information received from the computer and (iii) the pointer is stored in a look-up table associated
5 with the database.

1 55. The system of claim 47, wherein the first program comprises one or more
2 queries and one or more response choices for the individual.

1 56. The system of claim 55, wherein the remote processing apparatus comprises
2 a human interface configured to receive one or more responses from the individual to the queries to
3 be communicated to the central processing unit.

1 57. The system of claim 47, wherein the remote processing apparatus is
2 sufficiently compact to be hand-held and carried by the individual.

1 58. The system of claim 48, wherein the report comprises a graph illustrating
2 several measurements of the blood glucose data.

1 59. A system for monitoring a physiological condition of an individual using a
2 communication network, comprising:

3 a central processing unit (A) having access to one or more databases and (B)
4 configured to (i) generate a first program that collects blood glucose data relating to the physiological
5 condition of the individual, (ii) add input data received from the communication network to the first
6 program to adapt the first program to the individual, (iii) assign the first program to the individual
7 in response to input information received from the communication network and (iv) transmit the first
8 program via the communication network;

9 a remote processing apparatus remotely located from and in signal communication
10 with the central processing unit via the communication network, wherein the remote processing
11 apparatus is configured to (i) receive the first program from the communication network, (ii) connect
12 to a measuring device, (iii) execute the first program to collect the blood glucose data according to
13 a collect command in the first program and (iv) transmit the blood glucose data to the central
14 processing unit via the communication network; and

15 a computer remotely located from and in signal communication with the central
16 processing unit via the communication network, wherein the computer is configured to (i) transmit
17 the input data to the central processing unit via the communication network, (ii) transmit the input
18 information to the central processing unit via the communication network, (iii) receive the blood

19 glucose data from the central processing unit via the communication network and (iv) present a
20 report generated based on the blood glucose data to a health care provider.

1 60. The system of claim 59, wherein the physiological condition comprises
2 diabetes and the measuring device comprises a blood glucose measurement device.

1 61. The system of claim 59, wherein the computer is further configured to (i)
2 enable the health care provider to enter the input information and (ii) communicate the input
3 information to the central processing unit.

1 62. The system of claim 59, wherein (i) the central processing unit is further
2 configured to generate the report based on the blood glucose data and (ii) transmit the report to the
3 computer via the communication network.

1 77. A method of monitoring a physiological condition of an individual using a
2 communication network, the method comprising the steps of:

3 (A) transmitting input data from a computer to a central processing unit via the
4 communication network, wherein the computer is remotely located from and in signal
5 communication with the central processing unit via the communication network;

6 (B) transmitting input information from the computer to the central processing
7 unit via the communication network;

(C) reading a template program from a database into the central processing unit;

(D) generating a first program in the central processing unit by modifying the template program in response to the input data;

(E) assigning the first program to the individual in response to the input information;

(F) transferring the first program from the central processing unit to a remote processing apparatus via the communication network, wherein the remote processing apparatus is remotely located from and in signal communication with the central processing unit via the communication network;

(G) connecting the remote processing apparatus to a measuring device;

(H) executing the first program in the remote processing apparatus to collect measurement data from the measuring device;

(I) transmitting the measurement data from the remote processing apparatus to the central processing unit via the communication network;

(J) transmitting the measurement data from the central processing unit to the computer via the communication network; and

(K) presenting a report generated based on the measurement data from the computer to a health care provider.

1 78. The method of claim 77, wherein the physiological condition comprises
2 diabetes, the measuring device comprises a blood glucose measurement device and the measurement
3 data comprises blood glucose data.

1 79. The method of claim 78, further comprising the step of:
2 generating the report in the central processing unit based upon the blood glucose data.

1 80. The method of claim 79, further comprising the step of:
2 transmitting the report to the computer via the communication network.

1 81. The method of claim 78, wherein the report comprises a graph illustrating
2 several measurements of the blood glucose data.

1 82. The method of claim 78, further comprising the step of:
2 collecting the measurement data at the remote processing apparatus from the
3 measuring device according to a collect command of the first program.

1 83. The method of claim 82, further comprising the step of:
2 generating a message from the remote processing apparatus prompting the individual
3 to connect the blood glucose measurement device to the remote processing apparatus.

1 84. A method of monitoring a physiological condition of an individual using a
2 communication network, the method comprising the steps of:

3 (A) transmitting input data from a computer to a central processing unit via the
4 communication network, wherein the computer is remotely located from and in signal
5 communication with the central processing unit via the communication network;

6 (B) transmitting input information from the computer to the central processing
7 unit via the communication network;

8 (C) adding the input data received from the computer to a first program in the
9 central processing to adapt the first program to the individual, wherein the first program collects
10 blood glucose data relating to the physiological condition of the individual;

11 (D) assigning the first program to the individual in response to the input
12 information;

13 (E) transmitting the first program from the central processing unit to the a remote
14 processing apparatus via the communication network, wherein the remote processing apparatus is
15 remotely located from and in signal communication with the central processing unit via the
16 communication network;

17 (F) connecting the remote processing apparatus to a measuring device;

18 (G) executing the first program in the remote processing apparatus to collect the
19 blood glucose data from the measuring device according to a collect command of the first program;

20 (H) transmitting the blood glucose data from the remote processing apparatus to
21 the central processing unit through the communication network;

22 (I) transmitting the blood glucose data from the central processing unit to the
23 computer via the communication network; and

24 (J) presenting a report generated based on the blood glucose data from the
25 computer to a health care provider.

1 85. The method of claim 84, wherein the physiological condition comprises
2 diabetes and the measuring device comprises a blood glucose measurement device.

1 86. The method of claim 84, further comprising the step of:
2 generating the report in the central processing unit based upon the blood glucose data.

1 87. The method of claim 86, further comprising the step of:
2 transmitting the report from the central processing unit to the computer via the
3 communication network.

1 88. The method of claim 84, wherein the report comprises a graph illustrating
2 several measurements of the blood glucose data.

1 89. The method of claim 85, further comprising the step of:
2 generating a message from the remote processing apparatus prompting the individual
3 to connect the blood glucose measurement device to the remote processing apparatus.

1 90. The method of claim 85, wherein the transmitting of the blood glucose data
2 from the remote processing apparatus to the central processing unit is according to a transmit
3 command of the first program.

1 91. One or more processor readable non-transitory storage devices having
2 processor readable code embodied thereon, the processor readable code being configured to program
3 one or more processors to perform a method of monitoring a physiological condition of an individual
4 using a communication network, the method comprising the steps of:

5 (A) transmitting input data from a computer to a central processing unit via the
6 communication network, wherein the computer is remotely located from and in signal
7 communication with the central processing unit via the communication network;

8 (B) transmitting input information from the computer to the central processing
9 unit via the communication network;

10 (C) reading a template program from a database into the central processing unit;

11 (D) generating a first program in the central processing unit by modifying the
12 template program in response to the input data;

13 (E) assigning the first program to the individual in response to the input
14 information;

15 (F) transmitting the first program from the central processing unit to a remote
16 processing apparatus via the communication network, wherein the remote processing apparatus is

remotely located from and in signal communication with the central processing unit via the communication network;

(G) connecting the remote processing apparatus to measuring device;

(H) executing the first program in the remote processing apparatus to collect measurement data from the measuring device;

(I) transmitting the measurement data from the remote processing apparatus to the central processing unit via the communication network;

(J) transmitting the measurement data from the central processing unit to the computer via the communication network; and

(K) presenting a report generated based on the measurement data from the computer to a health care provider.

92. The processor readable non-transitory storage devices of claim 91, wherein the physiological condition comprises diabetes, the measuring device comprises a blood glucose measurement device and the measurement data comprises blood glucose data.

93. The processor readable non-transitory storage devices of claim 92, the method further comprising the step of:
generating the report in the central processing unit based upon the blood glucose data.

1 94. The processor readable non-transitory storage devices of claim 93, the method
2 further comprising the step of:
3 transmitting the report to the computer via the communication network.

1 95. The processor readable non-transitory storage devices of claim 92, wherein
2 the report comprises a graph illustrating several measurements of the blood glucose data.

1 96. The processor readable non-transitory storage devices of claim 92, the method
2 further comprising the step of:
3 collecting the blood glucose data in the remote processing apparatus as received from
4 the measuring device according to a collect command of the first program.

1 97. The processor readable non-transitory storage devices of claim 92, the method
2 further comprising the step of:
3 generating a message prompting the individual to connect the blood glucose
4 measurement device to the remote processing apparatus.

1 98. One or more processor readable non-transitory storage devices having
2 processor readable code embodied thereon, the processor readable code configured to program one
3 or more processors to perform a method of monitoring a physiological condition of an individual
4 using a communication network, the method comprising the steps of:

5 (A) transmitting input data from a computer to a central processing unit via the
6 communication network, wherein the computer is remotely located from and in signal
7 communication with the central processing unit via the communication network;

8 (B) transmitting input information from the computer to the central processing
9 unit via the communication network;

10 (C) adding the input data received from the computer to a first program in the
11 central processing to adapt the first program to the individual, wherein the first program collects
12 blood glucose data relating to the physiological condition of the individual;

13 (D) assigning the first program to the individual in response to the input
14 information;

15 (E) transmitting the first program from the central processing unit to the a remote
16 processing apparatus via the communication network, wherein the remote processing apparatus is
17 remotely located from and in signal communication with the central processing unit via the
18 communication network;

19 (F) connecting the remote processing apparatus to a measuring device;

20 (G) executing the first program in the remote processing apparatus to collect the
21 blood glucose data from the measuring device according to a collect command of the first program;

22 (H) transmitting the blood glucose data from the remote processing apparatus to
23 the central processing unit through the communication network;

24 (I) transmitting the blood glucose data from the central processing unit to the
25 computer via the communication network; and

26 (J) presenting a report generated based on the blood glucose data from the
27 computer to a health care provider.

1 99. The processor readable non-transitory storage devices of claim 98, wherein
2 the physiological condition comprises diabetes and the measuring device comprises a blood glucose
3 measurement device.

1 100. The processor readable non-transitory storage devices of claim 98, wherein
2 the method further comprises the step of:
3 generating the report in the central processing unit based upon the blood glucose data.

1 101. The processor readable non-transitory storage devices of claim 100, wherein
2 the method further comprises the step of:
3 transmitting the report to the computer via the communication network.

1 102. The processor readable non-transitory storage devices of claim 98, wherein
2 the report comprises a graph illustrating several measurements of the blood glucose data.

1 103. The one or more processor readable non-transitory storage devices of claim
2 98, wherein the method further comprises the step of:

generating a message prompting the individual to connect the measuring device to the remote processing apparatus.

104. The processor readable non-transitory storage devices of claim 98, wherein the transmitting of the measurement data from the remote processing apparatus to the central processing unit is according to a transmit command of the first program.

105. The system of claim 47, wherein the remote processing apparatus is further configured to intermittently establish a communication link with the central processing unit and (ii) disconnect the communication link after a period of time after each establishment.

106. The system of claim 59, wherein the remote processing apparatus is further configured to intermittently establish a communication link with the central processing unit and (ii) disconnect the communication link after a period of time after each establishment.

107. The method of claim 77, further comprising the steps of:
establishing a communication link between the central processing unit and the remote processing apparatus intermittently; and
disconnecting the communication link after a period of time after each establishment.

1 108. The processor readable non-transitory storage devices of claim 91, wherein
2 the method further comprises the steps of:
3 establishing a communication link between the central processing unit and the remote
4 processing apparatus intermittently; and
5 disconnecting the communication link after a period of time after each establishment.

1 109. The method of claim 84, wherein (i) a communication link between the central
2 processing unit and the remote processing apparatus is established intermittently and (ii)
3 disconnected a period of time after each establishment.

1 110. The processor readable non-transitory storage devices of claim 98, wherein
2 (i) a communication link between the central processing unit and the remote processing apparatus
3 is established intermittently and (ii) disconnected a period of time after each establishment.

IX. EVIDENCE APPENDIX

None.

X. RELATED PROCEEDINGS APPENDIX

Application 09/665,442, decided May 25, 2011; and Application 09/237,194, decided April 20, 2010.



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/665,442	09/19/2000	Stephen J. Brown	00-0920 / 7553.00055	5890
60683 7590 05/25/2011 HEALTH HERO NETWORK, INC. 2400 GENG ROAD, SUITE 200 PALO ALTO, CA 94303				
EXAMINER KOPPIKAR, VIVEK D				
ART UNIT 3685		PAPER NUMBER		
MAIL DATE 05/25/2011		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEPHEN J. BROWN

Appeal 2009-013563
Application 09/665,442
Technology Center 3600

Before: HUBERT C. LORIN, JOSEPH A. FISCHETTI, and BIBHU R.
MOHANTY, *Administrative Patent Judges*.

FISCHETTI, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Appellant seeks our review under 35 U.S.C. § 134 (2002) from the Examiner's final rejection of claims 47-49, 51-62 and 77-110. Claims 1-46, 50 and 63-76 are canceled.

We affirm-in-part and enter a new grounds of rejection pursuant to 37 CFR § 41.50(b).

THE CLAIMED INVENTION

Appellant claims a multi-user remote health monitoring system which is capable of identifying a particular user in a number of different ways and can also be used for tracking and collecting patient data (Specification 1:20-22). Claim 47 is illustrative of the claimed subject matter:

47. A system for monitoring a physiological condition of an individual using a computer network, comprising:

a central processing unit (A) having access to one or more databases and (B) configured to perform operations according to monitoring application programming, the central processing unit comprising (i) programming code configured to generate a script program that collects measurement data relating to the physiological condition of the individual and (ii) further programming code configured to assign the script program to the individual;

a remote processing apparatus (i) connectable to a measuring device to receive the measurement data according to a collect command contained in the script program and (ii) connectable to the central processing unit to transmit the measurement data to the central processing unit according to a transmit command contained in the script program; and

a workstation connectable to the central processing unit to receive the measurement data so that a health care provider may review a report generated based on the measurement data.

REFERENCES

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Fujimoto	US 5,339,821	Aug. 23, 1994
Heinonen	US 6,421,633 B1	Jul. 16, 2002

REJECTIONS

The following rejections are before us for review.

The Examiner rejected claims 47, 55-57, 77, 84, 91, 98, 105, and 107-110 under 35 U.S.C §102(b) over Fujimoto.

The Examiner rejected claims 48-49, 51-54, 58-62, 78-83, 85-90, 92-97, 99-104, and 106 under 35 U.S.C §103(a) over Fujimoto and Heinonen.

ISSUES

Did the Examiner err in rejecting claim 47 over Fujimoto as disclosing a *script program* which instructs a remote processing apparatus to collect and transmit measurement data to a central processing unit, since Fujimoto discloses software transferred to remote medical equipment to cause the remote medical equipment to collect and transmit measurement data to a centralized host computer?

Did the Examiner err in rejecting claims 48-49, 51-54, 58-62, 78-83, 85-90, 92-97, 99-104, and 106 under 35 U.S.C. § 103(a) over Fujimoto and Heinonen, since Heinonen's U.S. filing date is later than the priority date of the application, even though Heinonen's foreign priority date is earlier?

FINDINGS OF FACT

We find the following facts by a preponderance of the evidence.

1. The Specification describes that a script program is software that is executed by a remote apparatus, stating, "Script programs **40** are executed by apparatus **26** to communicate queries and messages to a patient, receive responses **42** to the queries, collect monitoring device measurements **44**, and transmit responses **42** and measurements **44** to server **18**." (Specification 9:33-10:2).
2. Fujimoto discloses the host computer generating a script program that is sent to the remote monitoring device for execution, stating, "the medical terminal equipment **1** is constructed so that it can store and execute a program transmitted to it from the host computer **5** ..." (Col. 8 ll. 62-66).
3. Fujimoto discloses a *remote processing apparatus connectable to a measuring device*, stating, "[t]he home medical system shown includes a medical terminal equipment **1** for measuring the blood pressure, the pulse, the electrocardiogram and so forth, and a user side communication apparatus or link **2**." (Col. 2 ll. 36-40).
4. The Specification describes that script programs are associated with a specific patient, by way of "Table **46** [which] contains a list of the patients and patient types to be monitored, and for each patient or patient type, a unique patient identification code, biometric enrollment information and a respective pointer to the script program assigned to the patient." (Specification 10:3-6).
5. Fujimoto discloses a doctor creating a user-specific script program of questions for the *remote processing apparatus* to ask a patient, which is then transmitted to the *remote processing apparatus* (Col. 5 ln. 68 to Col. 6 ln. 9).

6. Fujimoto discloses creation of a script program for a specific patient, since “the questions for diagnosis inquiry can be designated for each user, diagnosis inquiry effective for the disease or the condition of a particular user can be performed.” (Col. 6 ll. 26-29).
7. Fujimoto discloses a script program executed at the *remote processing apparatus* to initiate collection of data from an attached medical measurement device, which in one embodiment measures blood pressure using a blood pressure arm band (Col. 4 ll. 14-59).
8. Fujimoto discloses the *remote processing apparatus* contains instructions to *transmit the measurement data to the central processing unit*, stating, “[t]he transmission of the data may be performed by accessing of the user side to the medical institution side or may be performed by accessing of the medical institution side so that the medical institution receives data stored in the user side communications apparatus 2.” (Col. 7 ln. 67 to Col. 8 ln. 4).
9. Fujimoto discloses a transmission of data that utilizes data compression before termination, such that “the transmission is completed in about 5 to 10 seconds or so.” (Col. 8 ll. 49-55).
10. Fujimoto discloses a *workstation* at the display unit, because the system “includes a host computer 5 with a display unit on the medical institution side, and the additional equipments such as a printer apparatus 6 and an external storage apparatus 7” (Col. 2 ll. 50-55).
11. Fujimoto discloses that each medical terminal equipment 1 unit has a registered number identifying it (Col. 3 ln. 65 to Col. 4 ln. 2).

12. Fujimoto discloses patient identification numbers “must be inputted in advance” if a medical terminal equipment 1 unit will be used by multiple patients (Col. 7 ll. 60-63).
13. Fujimoto discloses that the host computer 5/*central processing unit* can store results from thousands of patients in its storage media (Col. 8 ll. 14-21).
14. Fujimoto discloses that medical data is transmitted to the host computer 1/*central processing unit* where it is viewed (Col. 8 ll. 8-14).
15. Fujimoto discloses instructions to ask a user if they are ready to measure their blood pressure, and giving guidance to connect the arm band of the measuring device to do so. (Col. 4 ll. 14-34).
16. Fujimoto discloses the removable connection of a *measurement device* to a *remote processing apparatus* in that a “pair of measuring electrodes 18 for measuring an electrocardiogram are removably connected to a front portion of the medical terminal equipment 1 by way of a cable 19.” (Col. 3 ll. 3-6).

ANALYSIS

Rejection under 35 U.S.C. § 102(b)

Claims 47 and 55-57

The rejection is affirmed as to claims 47 and 55-57. Appellant does not provide a substantive argument as to the separate patentability of claims 55-57 that depend from claim 47, which is the sole independent claim among those claims. Therefore, we address only claim 47, and claims 55-57 fall with claim 47. *See*, 37 C.F.R. § 41.37(c)(1)(vii)(2004).

Appellant argues, “[n]owhere in the above text, or in any other section does Fujimoto appear to mention **programming code** generating a **script program** that collects measurement data relating to the physiological condition of the individual.” (Appeal Br. 17).

We are not persuaded by Appellant’s argument. The Specification describes that a script program is software for execution by a *remote processing apparatus* (FF 1), and we find Fujimoto discloses such executable computer software, because Fujimoto discloses software programming in a host computer 5 sending a “program” to the medical terminal equipment 1 (*remote processing apparatus*) for execution (FF 2) to collect medical information from the patient (FF 3), which we find meets the claim language (i) *programming code configured to generate a script program that collects measurement data relating to the physiological condition of the individual*.

Appellant next argues, “[n]owhere in any of the cited text, or in any other section does Fujimoto appear to mention any programming code configured to assign a script program to an individual.” (Appeal Br. 18).

We are not persuaded by Appellant’s argument. The Specification describes that assignment is an association between a program for execution at the *remote processing apparatus* and a patient (FF 4), and we find Fujimoto discloses sending an executable program designated for a particular patient to the *remote processing apparatus* for use by the particular patient (FF 5, 6), thus meeting the claim language (ii) *further programming code configured to assign the script program to the individual*.

Appellant argues, “[n]owhere in the cited text does Fujimoto appear to mention a measuring device to receive measurement data **according to a collect command** contained in a script program.” (Appeal Br. 20).

We are not persuaded by Appellant’s argument, because we find Fujimoto discloses a series of instructions to collect measurement data from a measuring device attached (FF 3) to a *remote processing apparatus* (FF 7). Therefore, we find Fujimoto meets the claim limitation *a remote processing apparatus (i) connectable to a measuring device to receive the measurement data according to a collect command contained in the script program*.

Appellant next argues, “[n]one of the cited text, or any section of Fujimoto appears to mention a **transmit command** in a script program causing measurement data to be sent from the medical apparatus 8 to the host computer 5.” (Appeal Br. 21).

We are not persuaded by Appellant’s argument, because we find Fujimoto discloses instructions in the program sent from the *central processing unit* to the *remote processing apparatus* which, by virtue of the inherent command characteristics of software, executes a *command* as part of the programming that causes the *remote processing apparatus* to transmit *measurement data* to the *central processing unit* (FF 8), thus meeting the claim limitation *(ii) connectable to the central processing unit to transmit the measurement data to the central processing unit according to a transmit command contained in the script program*.

Appellant final argues, “[n]othing in Fujimoto hints at a workstation, let alone expressly discloses an actual workstation. Furthermore, the Examiner does not offer any explanation as to what element of Fujimoto is allegedly similar to the claimed workstation.” (Appeal Br. 22).

We are not persuaded by Appellant's argument. We broadly interpret *workstation* to be a computer terminal, and we find Fujimoto discloses a computer terminal comprising a display unit attached to the host computer 5 at the medical institution (FF 8), which we find meets the claim language *a workstation connectable to the central processing unit to receive the measurement data so that a health care provider may review a report generated based on the measurement data*.

Claims 77 and 91

Initially, we note that the Appellant argues independent claims 77 and 91 together as a group (App. Br. 23, 28). Correspondingly, we select representative claim 77 to decide the appeal of these claims, with remaining claim 91 standing or falling with claim 77. *See*, 37 C.F.R. § 41.37(c)(1)(vii) (2004).

Claim 77 recites, in pertinent part, a method comprising the steps of (A) storing a script assignment that associates the script program with the individual; (B) connecting the central processing unit with the remote processing apparatus; (C) transferring the script program from the central processing unit to the remote processing apparatus; (D) executing the script program in the remote processing apparatus to collect measurement data from the measuring device; and (E) transmitting the measurement data from the remote processing apparatus to the central processing unit upon execution of a transmit command of the script program.

Appellant argues, "nowhere in the cited text, or in any other section does Fujimoto appear to mention an act of storing a script assignment that associates a script program with an individual." (Appeal Br. 24).

We are not persuaded by Appellant's argument, because as we found above, Fujimoto *assigns/associates/designates* the program with an individual by sending stored instructions to the *remote processing apparatus* associated with an individual (FF 5, 6), therefore meeting the claim language (A) *storing a script assignment that associates the script program with the individual*.

Appellant argues, "the Examiner does not cite any text or elements in the figures of Fujimoto in rejecting both (C) the transferring step and (D) the executing step." (Appeal Br. 25).

We are not persuaded by Appellant's argument, because we find Fujimoto discloses transferring instructions from the *central processing unit/host computer 5* to the *remote processing apparatus/ medical terminal equipment 1* (FF 2), which executes to collect measurements from the device (FF 3, 7), thus meeting the claim language (C) *transferring the script program from the central processing unit to the remote processing apparatus; (D) executing the script program in the remote processing apparatus to collect measurement data from the measuring device*.

The remainder of the arguments as to claims 77 and 91¹ are substantially similar to the ones already addressed as set forth above at claim 47.

Claims 84 and 98

Initially, we note that the Appellant argues independent claims 84 and 98 together as a group (App. Br. 28). Correspondingly, we select

¹ We assume the reference to claim 79 on page 28 of the Reply Brief is a typographical error in which claim 91 was intended, since it falls in the section arguing claims 77 and 91, and claim 79 is argued separately.

representative claim 84 to decide the appeal of these claims, with remaining claim 98 falling with claim 84. *See*, 37 C.F.R. § 41.37(c)(1)(vii) (2004).

Claim 84 recites, in pertinent part, a method comprising the steps of (A) transmitting the script program through a communication link from the central processing unit to the remote programming apparatus; (B) disconnecting the communication link after the scrip program has been transmitted; (C) collecting measurement data in the remote processing apparatus as received from the measuring device according to a collect command of the script program; (D) connecting the communication link between the remote processing apparatus and the central processing unit after the measurement data has been collected; and (E) transmitting the measurement data from the remote processing apparatus to the central processing unit through the communications link.

Appellant argues, “nowhere in the cited text, or in any other section does Fujimoto appear to mention disconnecting a communication link on a telecommunication line 4 after a program has been transmitted from the host computer 5 to the medical apparatus 8.” (Appcal Br. 29).

We are not persuaded by Appellant’s argument, because Fujimoto discloses transmitting data to the *central processing unit* (FF 8), and because this transmission terminates and is not continuous (FF 9), we find it inherent in Fujimoto that the *communication link* is *disconnected* after a transmission. We also find that Fujimoto provides separate disclosures for transmitting instructions to the *remote programming apparatus* (FF 2) and transmitting data to the *central processing unit* (FF 8), such that these actions may be conducted during separate communications sessions.

The final argument about *receiving measurement data according to a collect command contained in the script program* is addressed above, as set forth at claim 47.

Claims 105 and 107-110

Initially, we note that the Appellant argues dependent claims 105 and 107-110, each of which depends from a different independent claim, together as a group (App. Br. 33). Correspondingly, we select representative claim 105 to decide the appeal of these claims, with remaining claims 107-110 falling with claim 105. *See*, 37 C.F.R. § 41.37(c)(1)(vii) (2004).

Claim 105 recites, in pertinent part, *wherein the remote processing apparatus is further configured to intermittently establish a communication link with the central processing unit and (ii) disconnect the communication link after a period of time after each establishment.*

Appellant argues, “nowhere in the cited text, or in any other section does Fujimoto appear to mention that the medical apparatus 8 both (i) **intermittently** establishes a communication link on the telecommunication line 4 and (ii) **disconnects the communication link after a period of time after each establishment.**” (Appeal Br. 33).

We are not persuaded by Appellant’s argument, because the communication between the *remote programming apparatus* and the *central processing unit* in Fujimoto is inherently *intermittent* and includes *disconnecting the communication link* because measurement data for transmission is locally stored in anticipation of transfer (FF 8), and communication is initiated by a program and is therefore not continuous (FF 8), thus meeting the claim language.

Rejection under 35 U.S.C. § 103(a)

Heinonen Prior Art

Appellant argues at claims 48, 51, 58, 59, 60, 62, 78, 79, 81, 85, 86, 88, 92, 93, 95, 99, 100, and 102 directly, or indirectly as to all claims rejected under 35 U.S.C. § 103(a), that "Heinonen et al. are not valid prior art for the 35 U.S.C. § 103 (a) rejection. Heinonen et al. was first filed in the United States on May 21, 1998. In contrast, the present application claims priority to United States Patent No. 6,101,478 to Brown (hereafter Brown '478), which was filed November 21, 1997 and fully supports all the pending claims." (Appeal Br. 37, 45, 50, 56).

We agree with Appellant. The instant application, filed September 19, 2000, claims priority by a continuation-in-part of application 09/517140, filed March 2, 2000, which claims priority by a continuation of application 08/975774, filed November 21, 1997. Support for claims 48, 59, 60, 78, 85, 92, and 99, which introduce blood glucose measurement for patients with diabetes, is present in the 08/975774 Specification at page 21 lines 19-22. Therefore the application is entitled to priority as of November 21, 1997 for at least the diabetes/blood glucose limitations in claims 48, 59, 60, 78, 85, 92, and 99 which led to the Examiner's application of Heinonen for all claims rejected under 35 U.S.C. § 103(a).

Heinonen, which was published in 2002, would be available as prior art under 35 U.S.C. § 102(e) as of its U.S. filing date of May 21, 1998, but no benefit of the foreign application is given under 35 U.S.C. § 102(e) for prior art purposes. *In re Hilmer*, 359 F.2d 859 (C.C.P.A. 1966). Therefore, Heinonen, with a 102(e) date of May 21, 1998, is not valid prior art in the instant application, with a priority date of November 21, 1997, and the

rejection under 35 U.S.C. § 103(a) of claims 48, 49, 51-54, 58-62, 78-83, 85-90, 92-97, 99-104, and 106 cannot be sustained.

New Grounds of Rejection under 35 U.S.C. § 103(a)

Pursuant to 37 CFR § 41.50(b) (2006) we enter a new grounds of rejection under 35 U.S.C. § 103(a) over Fujimoto of claims 48, 49, 51-54, 58-62, 78-83, 85-90, 92-97, 99-104, and 106.

We find that Fujimoto discloses in the Background the desirability of a remote measurement system for application to patients undergoing continuous ambulatory peritoneal dialysis (Col. 1, ll. 49-57). It is our understanding that remote monitoring is desirable in other situations where diseases require monitoring, such as in the case of diabetes. We therefore find it would have been obvious to one of ordinary skill in the art to substitute a blood glucose monitoring device in place of the blood pressure or EKG equipment disclosed in Fujimoto, and extend the application of the Fujimoto system and apparatus to patients with diabetes. *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007).

We accept as our own the Examiner's findings, other than those relying on Heinonen, as to claims 48, 49, 51-54, 58-62, 78-83, 85-90, 92-97, 99-104, and 106 (Answer 6-13). Among these claims, claims 48, 51, 58-60, 62, 78, 79, 81, 83, 85, 86, 88, 89, 90, 92, 93, 95-97, 99, 100, and 102 recite limitations concerning the measurement of blood glucose levels, and remaining claims 49, 52-54, 61, 80, 82, 87, 94, 101, 103, 104, and 106 depend from claims 48, 59, 60, 78, 79, 86, 93, 99, and 100.

In addition to the Examiner's findings, we add the following findings of obviousness for claims 49, 52-54, 61, 80, 83, 87, 89, 94, 97, 101, and 103.

Claims 49 and 61

We find Fujimoto includes a workstation in the form of a host computer and display unit (FF 2, 10), and find it inherent that this system includes the necessary peripherals and programming to *comprise script entry programming configured to (i) receive input information from the health care provider and (ii) communicate the input information to the central processing unit*. This is because the display unit and peripherals are a user terminal on a host computer which we find is a *workstation*, thus meeting the claim language.

Claim 52

We broadly interpret *script interpreter* to be portions of internal computer workings for the execution of software programs (FF 1), which one of ordinary skill in the art would recognize as being disclosed by Fujimoto as integral to the medical terminal equipment 1 and host computer 5 (FF 2).

Claim 53

We find Fujimoto discloses that a doctor may create a customized series of questions for an individual patient (FF 5). We also find Fujimoto discloses that each medical terminal equipment 1 (*remote processing apparatus*) has a registration number associated with it (FF 11), and if multiple patients will share use of a medical terminal equipment 1 (*remote processing apparatus*), then patient identification numbers must be input “in advance” of use (FF 12). We further find that one of ordinary skill in the art would recognize that Fujimoto thus discloses the association of a *unique patient identification code associated with the individual* in the form of either a patient number or unit registration number associated with the

script/questions, so that the customized series of instructions/questions can be directed to the correct patient, thus meeting the claim language.

Claim 54

We find that Fujimoto discloses a form of a *pointer* that is *related to the individual* in the form of the patient identification numbers and unit registration numbers (FF 11, 12) tied to the unique questions created by the doctor for an individual patient (FF 5), and that Fujimoto also discloses storing results from thousands of patients at the host computer/*central processing unit* (FF 13). The artisan of ordinary skill in the art would recognize that this storage of individual results would necessitate that this *pointer* be stored in a *look-up table*, or similar index, to enable selective access to the appropriate records in the host computer's storage.

Claims 80, 87, 94 and 101

We find, as set forth above at claim 47, that Fujimoto discloses a *workstation* at the host computer 1/*central processing unit* (FF 10), and we further find that one of ordinary skill in the art would recognize that viewing the report at the host computer 1/*workstation* (FF 14) is equivalent to *transmitting the report to a workstation connected with the central processing report*, thus meeting the claim language.

Claims 83, 89, 97 and 103

We find that Fujimoto discloses instructions to cause the *remote processing apparatus* to instruct the patient to connect a blood pressure arm cuff to their arm in order to take a blood pressure measurement (FF 15). We also find that Fujimoto discloses that measuring devices are "removably connected" to the *remote processing apparatus* (FF 16). We find one of ordinary skill in the art would recognize that it would be obvious to extend

Fujimoto's instructions to connect the arm band, to additionally instruct the patient *to connect the blood glucose measurement device to the remote processing apparatus*, because this is a common-sense extension based on the need to ensure a removable, necessary component is connected before proceeding. *KSR* at 419-420.

CONCLUSIONS OF LAW

The Examiner did not err in rejecting claims 47, 55-57, 77, 84, 91, 98, 105, and 107-110 under 35 U.S.C §102(b) over Fujimoto.

The Examiner erred in rejecting claims 48-49, 51-54, 58-62, 78-83, 85-90, 92-97, 99-104, and 106 under 35 U.S.C §103(a) over Fujimoto and Heinonen.

We enter a new grounds of rejection pursuant to 37 CFR § 41.50(b) (2006) under 35 U.S.C. § 103(a) over Fujimoto of claims 48-49, 51-54, 58-62, 78-83, 85-90, 92-97, 99-104, and 106.

DECISION

For the above reasons, the Examiner's rejection of claims 47, 55-57, 77, 84, 91, 98, 105, and 107-110 is **AFFIRMED**. The Examiner's rejection of claims 48-49, 51-54, 58-62, 78-83, 85-90, 92-97, 99-104, and 106 is **REVERSED**. We enter a new grounds of rejection pursuant to 37 CFR § 41.50(b) (2006) under 35 U.S.C. § 103(a) over Fujimoto of claims 48-49, 51-54, 58-62, 78-83, 85-90, 92-97, 99-104, and 106.

This decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b) (2008). 37 C.F.R. § 41.50(b) provides "[a] new ground of

rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 CFR § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

- (1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner
- (2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2006).

AFFIRMED-IN-PART; 37 C.F.R. § 41.50(b).

MP



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/237,194

01/26/1999

STEPHEN JAMES BROWN

99-0120 / 7553.00029

9517

60683 7590 04/20/2010
HEALTH HERO NETWORK, INC.
2400 GENG ROAD, SUITE 200
PALO ALTO, CA 94303

EXAMINER

MORGAN, ROBERT W

ART UNIT

PAPER NUMBER

3626

MAIL DATE

DELIVERY MODE

04/20/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

1 UNITED STATES PATENT AND TRADEMARK OFFICE

2
3
4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6

7
8 *Ex parte* STEPHEN JAMES BROWN
9

10
11 Appeal 2009-002452
12 Application 09/237,194
13 Technology Center 3600
14

15
16 Decided: April 20, 2010
17

18
19 Before HUBERT C. LORIN, ANTON W. FETTING, and
20 BIBHU R. MOHANTY, *Administrative Patent Judges*.
21 FETTING, *Administrative Patent Judge*.

22
DECISION ON APPEAL

STATEMENT OF THE CASE

Stephen James Brown (Appellant) seeks review under 35 U.S.C. § 134 (2002) of a final rejection of claims 34-138, the only claims pending in the application on appeal.

We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION¹

We AFFIRM.

THE INVENTION

The Appellant invented a self-care health monitoring arrangement that gathers data important to a health management program (Specification 1:Field of the Invention).

An understanding of the invention can be derived from a reading of exemplary claim 34, which is reproduced below [bracketed matter and some paragraphing added].

34. A networked health-monitoring system, comprising:

(a) a plurality of remote patient sites, each site including

(i) at least one display;

(ii) a data management unit configured to facilitate collection of patient health-related data;

¹ Our decision will make reference to the Appellant's Appeal Brief ("App. Br.," filed March 31, 2008) and Reply Brief ("Reply Br.," filed September 4, 2008), and the Examiner's Answer ("Ans.," mailed July 7, 2008).

- (iii) a memory; and
- (iv) stored program instructions for use in generating health-monitoring related information on the display;
- (b) at least one remotely located computing facility including at least one central server connectable for communication with the data management units at the patient sites,
- the central server configured to receive and store the patient health-related data from the data management unit at the remote patient sites; and
- (c) at least one health care professional computer remotely located from and configured for signal communication with the central server,
- wherein the central server can generate a report based on the patient health-related data collected at the remote patient site and the report can be viewed at the at least one healthcare professional computer and
- wherein at least one message can be sent from the healthcare professional computer to the remote patient sites through the central server.

THE REJECTIONS

The Examiner relies upon the following prior art:

Fu	US 4,803,625	Feb. 7, 1989
Lee	US 4,838,275	Jun. 13, 1989
Kirk	US 5,390,238	Feb. 14, 1995
Beckers	US 5,019,974	May 28, 1991
Fujimoto	US 5,339,821	Aug. 23, 1994

Claims 34-41, 45-50, 52, 54-59, 61-63, 65, 66, 69-75, 77-84, 88-93, 95, 97-102, 104-106, 108, 109, and 112-118 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Fu, Lee, and Kirk.

1 Claims 42, 44, 85, and 87 stand rejected under 35 U.S.C. § 103(a) as
2 unpatentable over Fu, Lee, Kirk, and Beckers.

3 Claims 51, 53, 60, 64, 67 94, 96, 103, 107, 110, and 111 stand rejected
4 under 35 U.S.C. § 103(a) as unpatentable over Fu, Lee, Kirk, and Fujimoto.

5 Claims 43 and 86 stand rejected under 35 U.S.C. § 103(a) as
6 unpatentable over Fu, Lee, Kirk, and Official Notice.

7 Claims 76 and 119-138 stand rejected under 35 U.S.C. § 103(a) as
8 unpatentable over Fu, Lee, Kirk, and Official Notice.

9 ARGUMENTS

10 The Appellant argues the claims rejected under 35 U.S.C. § 103(a) as
11 unpatentable over Fu, Lee, and Kirk as a group. Accordingly, we select
12 claim 34 as representative of the group. 37 C.F.R. § 41.37(c)(1)(vii) (2008).

13 The Appellant contends that he invented the claimed subject matter prior
14 to the filing date of Kirk and therefore the Kirk reference is not prior art.

15 ISSUES

16 The issue of whether the Appellant has sustained its burden of showing
17 that the Examiner erred in rejecting claims 34-138 under 35 U.S.C. § 103(a)
18 as unpatentable over Fu, Lee, Kirk, and the remaining art turns on whether
19 the Appellant adequately swore behind Kirk as prior art.

20

21

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

Facts Related to the Prior Art

Kirk

01. The filing date of Kirk is June 15, 1992.

Facts Related To the Appellant's Declaration Under 37 C.F.R. § 1.131

02. There are two declarations in the evidence appendix. One is dated September 19, 2006. Attached to it are Exhibits labeled A through AB.

03. The declaration states that exhibit B is the evidence of conception. Declaration ¶ 8.

04. Exhibit B is a one page letter dated March 2, 1992, from Steve Brown of Raya Systems to Drs. Jersch and Keiser indicating acceptance of an order for Camit 2.5 indicating a desire to begin development on April 26. There are no details of any method or machine other than the names of some devices. There are no details showing the specific components recited in the claims.

05. The declaration states that exhibits C to AB are the evidence of diligence. Declaration ¶ 10.

06. Exhibit C is a query to the Director of a diabetes research program as to the propriety of applying for funding. The query indicates that commercial development is anticipated. A copy of a Department of Health and Human Services Small Business

Innovation Research Programs grant application is appended. No specific details of development of the claimed subject matter are provided.

07. Exhibit D is a project plan for KinderCamit. The plan includes a preliminary design document that portrays screen shots, but provides little specification as to the underlying functionality and does not specify how the claimed subject matter is to be implemented at the level of detail in the claims. No specific details of development activities of the claimed subject matter are provided.

08. Exhibit E is a draft letter proposing to initiate intellectual property protection measures from an attorney. No specific details of development activities of the claimed subject matter are provided.

09. Exhibit F is an invoice from an attorney and a check in payment thereof. Numerous activities are listed, none of which pertain to drafting a patent application. All dates are prior to Kirk's filing date. No specific details of development activities of the claimed subject matter are provided.

10. Exhibit G is a letter laying out a proposed development timetable for Camit S 2.5. Declaration ¶ 19 states that this corresponds to the provider interface. The phrase "provider interface" occurs in none of the claims. Numerous proposed generic activities are listed, none of which pertain to specific

claim limitations. No specific details of development activities of the claimed subject matter are provided.

11. Exhibit H is a speaker release form and a letter from the American Diabetes Association acknowledging Mr. Brown's participation in the association's 52nd Scientific Sessions. No specific details of development activities of the claimed subject matter are provided.

12. Exhibit I is an invoice from an attorney and a check in payment thereof. Numerous activities are listed, none of which pertain to drafting a patent application. All dates are prior to Kirk's filing date. No specific details of development activities of the claimed subject matter are provided.

13. Exhibit J is a letter describing personnel assignment and hiring decisions. Declaration ¶ 22 states that this includes a development status report. No discernable description of the invention's development status is present except for a statement as to the need to start on Camit 2.5 and Diabcare documentation. The letter provides no translation from these names to the specific claim limitations. Therefore, how this letter relates to the need for documentation as to the claimed subject matter is not provided. No specific details of development activities of the claimed subject matter are provided.

14. Exhibit K is a one page bullet list of introductions, Raya Systems status, organization, and administrative issues. Declaration ¶ 23 states that this was a meeting agenda that listed

the Nintendo project related to the patient interface portion of the invention. Nothing in the agenda provides any details as to what was to be actually discussed. The phrase “patient interface” occurs in none of the claims. No specific details of development activities of the claimed subject matter are provided. The agenda is dated prior to Kirk’s filing date.

15. Exhibit L is a work for hire agreement draft. Declaration ¶ 24 states that this was for hiring Jay Clark for development of interactive patient self-care education software. No specific details of development activities of the claimed subject matter are provided. The cover sheet is dated prior to Kirk’s filing date.

16. Exhibit M is a letter from Sculptured Software indicating a desire to work with Raya Systems. Declaration ¶ 25 states that this was for hiring a software developer for development of interactive patient self-care education software. No specific details of development activities of the claimed subject matter are provided. The letter is dated prior to Kirk’s filing date.

17. Exhibit N is a letter to Boehringer Mannheim GmbH indicating a planning timetable that has been used and relating administrative problems affecting development. Declaration ¶ 26 states that this was a status report. The only status related in the letter is an expressed “hope to continue on this schedule” and a general statement that “experienced staff” have been added and the lack of decision making authority. No specific details of development activities of the claimed subject matter are provided. The letter is

the first exhibit dated subsequent to Kirk's filing date, being one day later.

18. Exhibit O is a letter to Dr. Klaus Piwernetz recapping a conversation and indicating that a dBase contractor was hired and that a conversion program had been provided and a desire to obtain certain information. Declaration ¶ 27 states that this was related to the database portion of the invention. No specific details of development activities of the claimed subject matter are provided. The letter is dated subsequent to Kirk's filing date, being three days later.

19. Exhibit P is an invoice from an attorney and a check in payment thereof. Numerous activities are listed, none of which pertain to drafting a patent application. All dates are prior to Kirk's filing date, except for activities relating to contract review and confidentiality agreements. No specific details of development activities of the claimed subject matter are provided.

20. Exhibit Q is a letter from Emerson Brooks. No invention development activities are listed. The letter describes an attached bill for personnel placement service for hiring Mr. Jack Thornton. A payroll register is also attached that shows that Mr. Thornton began work in June, the same month as Kirk's application was filed. No specific details of development activities of the claimed subject matter are provided. The letter is dated 10 days subsequent to Kirk's filing date.

- 1 21. Exhibit R is a proposal from Construction Specialties, Inc. for
2 construction work. Declaration ¶ 27 states that this was related
3 to the moving plans that were implemented between mid July and
4 mid August, 1992. No specific details of development activities
5 of the claimed subject matter are provided. The letter is dated 22
6 days subsequent to Kirk's filing date.
- 7 22. Exhibit S is a series of letters discussing participation at a trade
8 conference. No specific details of development activities of the
9 claimed subject matter are provided. The letters are dated
10 between 17 and 29 days subsequent to Kirk's filing date.
- 11 23. Exhibits T and U are copies of a non-disclosure agreement with
12 several high level system charts. Declaration ¶ 35 states that this
13 was a schematic. The schematic diagrams show high level
14 interconnections among several generic well known articles of
15 electronic equipment, but details of implementation to the level of
16 the claim limitations. Declaration ¶ 36 states that exhibit U was a
17 copy sent to the Appellant's patent attorney. No specific details
18 of development activities of the claimed subject matter are
19 provided. The letter is dated 59 days subsequent to Kirk's filing
20 date.
- 21 24. Exhibit V is handwritten note discussing the need for a
22 proposal. Declaration ¶ 37 states that this was indicative of
23 continuing development. The note makes reference to a prototype
24 with off the shelf components, but provides no indication of
25 whether such a prototype is prospective or not. No specific details

of development activities of the claimed subject matter are provided. The letter is dated 67 days subsequent to Kirk's filing date.

25. Exhibit W is a September 3, 1192 letter from attorneys to Raya Systems acknowledging that work on the patent application is authorized to begin. The letter indicates that a patentability search that will be used to amend the application is deferred an additional twenty days beyond the date of the letter. No specific details of development activities of the claimed subject matter are provided. The letter is dated 80 days subsequent to Kirk's filing date.

26. Exhibit X is a series of correspondence regarding an administrative review by the Department of Health and Human Services on a Phase II Small Business Innovation Research grant application. The response by Raya Systems lists budgetary matters but no actual details regarding activities on developing the invention. No specific details of development activities of the claimed subject matter are provided. The letters are dated 86 and 87 days subsequent to Kirk's filing date.

27. Exhibit Y is an October 2, 1992 draft of a patent application from the attorneys. No specific details of development activities of the claimed subject matter or of the drafting activities of the patent application are provided. The draft is dated 109 days subsequent to Kirk's filing date. The draft contains 28 pages of specification and 5 pages for 10 drawings.

- 1 28. Exhibit Z is a letter to the attorneys with a handwritten drawing.
2 The letter states that the drawing ought to be in the application.
3 The drawing is a high level diagram of an information flow
4 between a patient and physician and portrays several high level
5 structures through which information passes. No specific details
6 of development activities of the claimed subject matter or of the
7 drafting activities of the patent application are provided. The
8 letter is dated 109 days subsequent to Kirk's filing date.
- 9 29. Exhibit AA is an October 31, 1992 invoice from the patent
10 attorneys. The invoice shows that 8.2 hours were spent on
11 October 1 and 2, 1992 (108 and 109 days subsequent to Kirk's
12 filing date) and 6.6 hours on October 27-29 (134 and 136 days
13 subsequent to Kirk's filing date). The only activity during the 25
14 days between those dates is a 4.9 hour meeting. No specific
15 details of development activities of the claimed subject matter or
16 of the drafting activities of the patent application are provided.
- 17 30. Exhibit AB is the instant application filed 155 days subsequent
18 to Kirk's filing date.
- 19 31. The Appellant provided evidence of conception of the claimed
20 subject matter prior to Kirk's filing date.
- 21 32. The Appellant provided a timeline of the inventor's activities
22 between Kirk's filing date and the filing date of the instant
23 application.

- 1 33. The Appellant did not provide a timeline of the activities
2 reducing the invention to actual practice between Kirk's filing
3 date and the filing date of the instant application.
- 4 34. One cannot discern what activities in actual reduction to
5 practice occurred and when they occurred from the evidence in the
6 record.
- 7 35. The Appellant did not provide a timeline of the activities
8 reducing the invention to constructive practice between Kirk's
9 filing date and the filing date of the instant application.
- 10 36. One cannot discern what activities in constructive reduction to
11 practice occurred and when they occurred from the evidence in the
12 record.
- 13 37. The second declaration is dated June 8, 2004. Attached to it are
14 exhibits labeled 1 through 9. These exhibits are copies from
15 among those attached to the first declaration *supra*.

16 *Facts Related To The Application Disclosure*

- 17 38. The instant application was filed January 26, 1999.
- 18 39. The Application claims priority by way of a continuation in part
19 to Application 07/977,323, filed November 17, 1992. This is the
20 only application in the chain of priority that antedates the applied
21 prior art.
- 22 40. The Appellant has presented no evidence that the disclosure in
23 the 07/977,323 application provides a 35 U.S.C. § 112 compliant

written description of the inventions as recited in the instant
claims.

PRINCIPLES OF LAW

Obviousness

A claimed invention is unpatentable if the differences between it and the prior art are “such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

In *Graham*, the Court held that that the obviousness analysis is bottomed on several basic factual inquiries: “[(1)] the scope and content of the prior art are to be determined; [(2)] differences between the prior art and the claims at issue are to be ascertained; and [(3)] the level of ordinary skill in the pertinent art resolved.” *Graham*, 383 U.S. at 17. *See also KSR*, 550 U.S. at 406. “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR*, 550 U.S. at 416.

ANALYSIS

The sole issue before us is whether Kirk is a prior art reference. If it is, the Appellant has not argued that the combination of the reference would not render the invention obvious.

The Appellant filed a declaration under 37 C.F.R. § 1.131 as evidence of conception prior to Kirk’s filing date and diligence in constructive reduction to practice between the filing dates of Kirk and the instant application. We agree that the declaration includes evidence of conception prior to Kirk’s

1 filing date. Thus, the issue reduces to diligence in reducing to practice
2 during the 155 days between Kirk's filing and the effective filing date of the
3 instant application.

4 The instant application was filed January 26, 199 (FF 38), but has
5 claimed priority by way of continuations to April 26, 1994 and a
6 continuation in part to November 17, 1992 (FF 39). The Appellant has
7 provided no analysis of the differences between the 1992 disclosure and the
8 present application disclosure, or a mapping between the 1992 disclosure
9 and the present claims, to show that the present claims are fully supported by
10 the 1992 disclosure. FF 40. Thus, we first find that the Appellant has not
11 shown that the instant claims are entitled to the benefit of November 1992
12 application filing date.

13 Next, there remains the issue of whether the Appellant invented the
14 claimed subject matter prior to Kirk's filing date. The first issue as regards
15 invention is whether conception occurred prior to Kirk's filing date. The
16 Appellant filed two declarations. FF 02 and FF 37. The information in the
17 earlier declaration is essentially a subset of the latter. Both declarations refer
18 to a one page letter as evidence of conception. FF 03. This letter indicates
19 acceptance of an order for Camit 2.5 indicating a desire to begin
20 development on April 26. There are no details of any method or machine
21 other than the names of some devices. There are no details showing the
22 specific components recited in the claim. FF 04. Thus, we have no
23 objective evidence that the specific inventions recited in the claims were
24 conceived prior to the applied art.

1 The Appellant argues that he exercised diligence in reduction to practice.
2 However, no specific details of development activities of the claimed subject
3 matter are provided in the declarations and their attachments. It would
4 appear the Appellant is arguing that the entire period from the filing date of
5 Kirk to the date the patent attorney began constructive reduction to practice
6 was excused activity.

7 We agree that an inventor does not have to work on reduction to practice
8 every day, if reasonable excuse is provided. "A review of case law on
9 excuses for inactivity in reduction to practice reveals a common thread that
10 courts may consider the reasonable everyday problems and limitations
11 encountered by an inventor." *Griffith v. Kanamaru*, 816 F.2d 624, 626 (Fed.
12 Cir. 1987).

13 But this is not a general waiver of the requirement for showing that work
14 was performed in the reduction to practice, particularly when the every day
15 work was done in pursuing commercial development.

16 [E]xcuses [] in the nature of commercial development [are] not
17 accepted as an excuse for delay, [contrasted with] the
18 "hardship" cases. [] Delays in reduction to practice caused by
19 an inventor's efforts to refine an invention to the most
20 marketable and profitable form have not been accepted as
21 sufficient excuses for inactivity.

22 *Griffith*, 816 F.2d at 627. Many of the activities detailed in the declaration
23 and exhibits bear little direct relation to actually reducing the invention to
24 practice. Many of the activities are directed to establishing intellectual
25 property protection measures, obtaining speaking engagements, and
26 planning for staffing needs. Others, such as proposing development
27 timetables, are tangentially related, but show no actual reduction itself.

1 The activities that may be considered in a showing of diligence
2 can take a diversity of forms. Precedent illustrates the
3 continuum between, on the one hand, ongoing laboratory
4 experimentation, and on the other hand, pure money-raising
5 activity that is entirely unrelated to practice of the process. []
6 [E]fforts by the inventor to secure financial backing, by
7 showing the invention to prospective manufacturers over a four
8 year period, did not establish diligence toward reduction to
9 practice.

10 *Scott v Koyama*, 281 F.3d 1243, 1248 (Fed. Cir. 2002). No specific details
11 of development activities of the claimed subject matter are provided.
12 Simply put, we find no evidence concerning activities supporting the actual
13 reduction of the invention itself to practice in the record before us. This
14 takes us to the constructive reduction that is apparently relied upon.

15 Exhibit W is a September 3, 1992 letter from attorneys to Raya Systems
16 acknowledging that work on the patent application is authorized to begin.
17 The letter indicates that a patentability search that will be used to amend the
18 application is deferred an additional twenty days beyond the date of the
19 letter. No specific details of development activities of the claimed subject
20 matter are provided. This letter, evidencing the beginning of constructive
21 reduction, is dated 80 days subsequent to Kirk's filing date. FF 25.

22 Exhibit Y is an October 2, 1992 draft of a patent application from the
23 attorneys. No specific details of development activities of the claimed
24 subject matter or of the drafting activities of the patent application are
25 provided. This draft of a constructive reduction is dated 109 days
26 subsequent to Kirk's filing date and 46 days prior to the filing date of the
27 earliest application in the priority chain.

1 The only evidence of work that the patent attorney provided in the
2 period between commencement and this draft is an October 31, 1992
3 invoice. No specific details of development activities of the claimed subject
4 matter or of the drafting activities of the patent application. FF 29. This
5 shows just under 7 hours of work performed on October 1. The period from
6 September 3 to 30 is unaccounted for. Further, no activity is shown between
7 October 7 and October 27. To establish diligence for constructive reduction
8 to practice, the attorney's diligence must be shown.

9 "[R]easonable diligence can be shown if it is established that the
10 attorney worked reasonably hard on the particular application in question
11 during the continuous critical period." *Bey v. Kollonitsch* 806 F.2d 1024,
12 1027 (Fed. Cir. 1986). "[The inventor's] records did not show the exact
13 days when activity specific to this application occurred. Thus, we cannot
14 say that the board clearly erred in finding that "the documented activities
15 with regard to [the present application] are insufficient by themselves to
16 prove diligence." *Bey*, 806 F.2d at 1028.

17 It may have been that the attorney had a backlog to take care of between
18 September 3 and 30.

19 [I]t may not be possible for a patent attorney to begin working
20 on an application at the moment the inventor makes the
21 disclosure, because the attorney may already have a backlog of
22 other cases demanding his attention. Thus, the courts have
23 recognized that reasonable diligence is all that is required of the
24 attorney. [] Generally, the patent attorney must show that
25 unrelated cases are taken up in chronological order, thus, the
26 attorney has the burden of keeping good records of the dates
27 when cases are docketed as well as the dates when specific
28 work is done on the applications.

1 *Bey*, 806 F.2d at 1028. But there is no evidence of such a backlog or that if
2 there was a backlog that it was taken up in chronological order. There is
3 also no evidence showing that the period subsequent to the last documented
4 attorney activity on October 29 up to the date of filing was excused activity.
5 We are left with a large number of days in which no documented attorney
6 activity occurred and no evidence that those days were excusable.

7 Taking all of this evidence together, we have a claim to priority of a
8 continuation-in-part for which there is no showing that the earlier
9 application provides an adequate written description. The earlier application
10 was further filed subsequent to the applied art. We have no evidence that the
11 specific details of any of the claims were conceived prior to the applied art,
12 no specific details of development activities of the claimed subject matter or
13 of the drafting activities of the patent application, and no evidence that the
14 attorney was diligent in constructive reduction.

15 We cannot say that the documented activities with regard to the present
16 application are sufficient to prove diligence or conception. Even if they
17 were sufficient, there is no evidence that the 1992 application provided an
18 adequate written description for the instant claims. We conclude that all of
19 the references, and Kirk in particular, constitute prior art against the instant
20 claims. The Appellant presents no arguments that the claims are not obvious
21 over the art as applied.

22 CONCLUSIONS OF LAW

23 The Examiner did not err in rejecting claims 34-41, 45-50, 52, 54-59,
24 61-63, 65, 66, 69-75, 77-84, 88-93, 95, 97-102, 104-106, 108, 109, and 112-
25 118 under 35 U.S.C. § 103(a) as unpatentable over Fu, Lee, and Kirk.

1 The Examiner did not err in rejecting claims 42, 44, 85, and 87 under 35
2 U.S.C. § 103(a) as unpatentable over Fu, Lee, Kirk, and Beckers.

3 The Examiner did not err in rejecting claims 51, 53, 60, 64, 67 94, 96,
4 103, 107, 110, and 111 under 35 U.S.C. § 103(a) as unpatentable over Fu,
5 Lee, Kirk, and Fujimoto.

6 The Examiner did not err in rejecting claims 43 and 86 under 35 U.S.C.
7 § 103(a) as unpatentable over Fu, Lee, Kirk, and Official Notice.

8 The Examiner did not err in rejecting claims 76 and 119-138 under 35
9 U.S.C. § 103(a) as unpatentable over Fu, Lee, Kirk, and Official Notice.

10 DECISION

11 To summarize, our decision is as follows.

- 12 • The rejection of claims 34-41, 45-50, 52, 54-59, 61-63, 65, 66, 69-75,
13 77-84, 88-93, 95, 97-102, 104-106, 108, 109, and 112-118 under 35
14 U.S.C. § 103(a) as unpatentable over Fu, Lee, and Kirk is sustained.
- 15 • The rejection of claims 42, 44, 85, and 87 under 35 U.S.C. § 103(a) as
16 unpatentable over Fu, Lee, Kirk, and Beckers is sustained.
- 17 • The rejection of claims 51, 53, 60, 64, 67 94, 96, 103, 107, 110, and
18 111 under 35 U.S.C. § 103(a) as unpatentable over Fu, Lee, Kirk, and
19 Fujimoto is sustained.
- 20 • The rejection of claims 43 and 86 under 35 U.S.C. § 103(a) as
21 unpatentable over Fu, Lee, Kirk, and Official Notice is sustained.
- 22 • The rejection of claims 76 and 119-138 under 35 U.S.C. § 103(a) as
23 unpatentable over Fu, Lee, Kirk, and Official Notice is sustained.

1 No time period for taking any subsequent action in connection with this
2 appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

3

4 AFFIRMED

5

6

7

8 mev

9

10 Address

11 HEALTH HERO NETWORK, INC.
12 2400 GENG ROAD, SUITE 200
13 PALO ALTO CA 94303